Supreme Court, U.S.
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No. 03-

IN THE

Supreme Court of the United States

RICHARD SATAVA, an individual; SATAVA ART GLASS, a sole proprietorship,

Petitioners,

v.

CHRISTOPHER LOWRY, an individual; CHRISTOPHER RICHARDS, an individual; MAKAWAO GLASSWORKS, LLC, dba HOT ISLAND GLASS,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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73 pp

QUESTIONS PRESENTED

1. Whether a court's conclusion that the portion of a sculptural work of art that depicts an animal, or other subject matter said to be in the public domain, is "lifelike" or "realistic" deprives that artistic depiction of protection under the Copyright Act?

2. Whether a court's conclusion that elements in a work of art are unprotectable renders the work of art as a whole — *i.e.*, the artist's unprecedented combination of those elements — no more original than the mechanical alphabetical listing of unprotectable facts in a telephone directory, and thus not entitled to protection under the Copyright Act?

3. Whether the doctrine of "thin" copyright protection, derived from factual and other works where the range of potential expression is narrow, can be applied to works of art despite this Court's prior recognition that each artist's expression of even the same subject is different, and thus the range of potential expression is limitless?

STATEMENT PURSUANT TO RULE 29.6

Petitioner Richard Satava is an individual who owns and operates Petitioner Satava Art Glass, which is a privately owned sole proprietorship and has no publicly traded stock.

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Petitioners Richard Satava and his sole proprietorship Satava Art Glass (collectively "Satava") respectfully petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the Ninth Circuit in this case.

OPINIONS BELOW

The district court's opinion (per Burrell, D.J.) granting Satava's motion for a preliminary injunction is unpublished (Appendix ("Pet. App.") 14a-32a). The Court of Appeal's opinion (per Gould, J., joined by Silverman, J., and Weiner, D.J.) reversing the district court's opinion, is published at 323 F.3d 805 (Pet. App. 1a-13a). The Court of Appeals' order denying the petition for rehearing and for rehearing en banc is not published (Pet. App. 33a-34a).

STATEMENT OF JURISDICTION

The Court of Appeals entered its opinion and order on March 20, 2003, and denied rehearing and rehearing en banc on May 27, 2003. Petitioner Satava invokes this Court's jurisdiction under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

The provisions of the Copyright Act of 1976, 17 U.S.C. § 101 *et seq.*, relevant to this petition are reprinted in the Appendix at 35a-38a.

STATEMENT OF THE CASE

Petitioner Satava is a glass artist in California known for his glass-in-glass jellyfish sculptures, which are inspired by jellyfish but do not depict any particular species. Respondents own and operate a glass studio and gallery on Maui, where Satava's sculptures are widely available. After seeing Satava's jellyfish sculptures in 1996 and 1997, respondents began making and selling jellyfish sculptures which, though technically

inferior, confused customers, who bought respondents' work thinking it had been made by Satava. Finding that Satava had shown a likelihood of success on his claim for copyright infringement, the district court issued a preliminary injunction through trial. Based largely on respondents' own evidence — which showed, *inter alia*, that there were many different types of jellyfish in the sea and many different types of jellyfish glass art — the district court rejected respondents' argument that Satava's art was not entitled to copyright protection. Though respondents make several types of jellyfish sculptures, Satava only sought and obtained an injunction against respondents' sculptures that incorporate the same elements as Satava's sculptures. The Ninth Circuit reversed, holding that a critical element in Satava's sculptures, his depiction of a jellyfish, was unprotectable because the Ninth Circuit thought an artist should not be able to protect what a court views as a realistic portrayal of an animal or other subject matter in the public domain; that Satava's *work of art* as a whole, his unique combination of elements, was as unoriginal and unprotectable as the mechanical alphabetical listing of telephone numbers in a directory; and that any copyright Satava might have for "realistic" or "lifelike" *artistic* depictions of animals was as "thin" as the protection given to those factual compilations that do receive some copyright protection.

The Court of Appeal's holding merits this Court's immediate review because it strips artists of copyright protection — or, at least, of any meaningful protection — for art that a court, in its artistic judgment, believes to be a "realistic" depiction of an animal in its natural surrounding, a portrait of a person, or any other subject matter thought to be in the public domain. In addition, the decision below conflicts with numerous decisions of this Court and the other circuits, which have not only found such art to be protectable but have noted, in the words of Justice Holmes, that even the most modest work of art displays more originality than a directory.

1. Inspired by jellyfish he saw at the Monterey Bay Aquarium in the late 1980s, Petitioner Satava began experimenting with glass sculptures of jellyfish. By 1990, Satava had arrived at a design that incorporates the original combination of elements that continue to mark his jellyfish sculptures today: a vertically-oriented, colorful, fanciful jellyfish with tendril-like tentacles and a rounded bell encased in an outer layer of rounded, clear glass that is bulbous at the top and tapers toward the bottom to form roughly a bullet-shape, with the jellyfish portion of the sculpture filling almost the entire volume of the outer shroud. Satava's jellyfish sculptures were first exhibited at the Monterey Bay Aquarium in 1990, and by 1995 were being shown and sold in galleries across the country, including in Hawaii, which quickly became Satava's largest market. The Hawaiian galleries that have carried Satava's sculptures since 1995, including five galleries on the island of Maui alone, prominently display his work. Photographs of Satava's sculptures have appeared in national magazines and Hawaiian tourist brochures distributed throughout the islands. Satava owns valid copyright registrations for his jellyfish sculpture design, and has also registered derivative works incorporating the elements of that design.

2. Respondents operate a glass studio and gallery on Maui, Hot Island Glass ("HIG"), that is located near several galleries that have carried Satava's sculptures since 1995. Respondent Chris Lowry admitted seeing a picture of Satava's sculptures as early as 1996 and viewing one of Satava's sculptures in person in 1997, when a customer brought it to HIG to repair a scratch. In 1999, Satava learned that imitations of his jellyfish sculptures were being made and sold by Respondent Lowry, then an employee of HIG. Satava then contacted the owner of HIG, who agreed to stop selling the disputed sculptures. However, after Respondents Lowry and Chris Richards bought HIG, they resumed selling the disputed sculptures.

When various gallery owners observed to respondents that their sculptures were imitations of Satava's work, respondents did not deny the charge. On at least one occasion, Respondent Lowry told another gallery owner that appellants had to make and sell copies of works like Satava's sculptures, which were "proven to sell quickly," to cover the financial burden of purchasing the HIG. Respondent's sculptures have confused members of the public, who have bought their work thinking they were buying an original Satava jellyfish sculpture.

3. Satava filed this lawsuit in April 2001 and moved for a preliminary injunction in February 2002. After considering the motion for more than two months, the district court granted it. Based on a series of factual findings in a 17-page opinion, the district court rejected respondents' arguments that Satava's art was not entitled to copyright protection. The district court found respondents' merger argument — their argument that Satava could not prevent copying of his work on the theory that there is only one way to express the "idea" of a glass-in-glass jellyfish — was refuted by respondents' evidence showing the many different types of jellyfish sculptures they had made (as well as by Satava's evidence showing even further examples of different jellyfish sculptures). Pet. App. 21a-22a. The district court rejected respondents' arguments that the physiognomy and nature of jellyfish dictated the design of jellyfish sculptures based on respondents' own evidence, which showed that they could mold the glass enclosure to any shape they wanted (regardless of the shape of the item inside), that the shape of Satava's shroud was "unique" and not standard in glass-in-glass art, that "[j]ellyfish exist in a wide variety of forms, sizes, shapes and colors" and that there are "potentially limitless ways of depicting jellyfish in glass sculptures." *Id.* 23a-25a. As for respondents' public domain argument, the district court observed that the Ninth Circuit had previously rejected the argument that animal-based art was unprotectable because it depicted subject matter in the public domain. *Id.* 23a.

Applying the Ninth Circuit's long-standing test for infringement, the district court found that Satava had shown a likelihood he would succeed at trial in showing access and substantial similarity, which, in the Ninth Circuit, creates a presumption of irreparable injury sufficient to support a preliminary injunction. *Id.* 31a. The district court thus issued a preliminary injunction restraining appellants from "making and selling copies of Satava's jellyfish sculptures," which it defined as a sculpture incorporating the same elements as Satava's sculptures:

> [V]ertically oriented, colorful, fanciful jellyfish with tendril-like tentacles and a rounded [bell] encased in an outer layer of rounded clear glass that is bulbous at the top and tapering toward the bottom to form roughly a bullet-shape, with the jellyfish portion of the sculpture filling almost the entire volume of the outer, clear glass shroud

Id.

4. On respondents' expedited appeal, and only six weeks after argument in the Court of Appeals, the Ninth Circuit reversed in an opinion not only remarkable for its refusal to address the factual findings of the district court (which it did not and could not have found to be clearly erroneous, but instead superseded with its own unsupported factual assertions[1]),

[1] To cite just two examples, the Ninth Circuit asserted that Satava's sculptures "resemble the *pelagia colora* that live in the Pacific Ocean," Pet. App. 3a, when, in fact, it was *respondents* who claimed their sculptures were based on the *pelagia colorata*, a claim the district court had rejected because the photographs of *pelagia colorata* submitted by respondents looked nothing like their sculptures or Satava's, *id.* 24a & n.5; and the Ninth Circuit said Satava could not protect the vertical orientation of his sculptures because "jellyfish swim vertically in nature and often are depicted swimming vertically," *id.* 9a, when, in fact, the district court had found exactly the opposite because the evidence submitted by respondents showed most jellyfish do *not* swim vertically. *Id.* at 23a-24a.

but also for its failure to cite or abide by governing precedent of this Court, as well as many decisions of other circuits. The Ninth Circuit held, as a matter of law, that an artist's "lifelike glass-in-glass sculptures of jellyfish," or any other "animals in their natural surroundings," contained "unprotectable ideas and standard elements" derived from the public domain and therefore were not entitled to copyright protection, either for their constituent elements or as works of art as a whole (the artist's combination of aesthetic elements). Pet. App. 2a-3a, 13a. The Ninth Circuit found that Satava's novel combination of elements "lacks the quantum of originality needed to merit copyright protection" for the same reason that this Court had previously found a mechanical factual compilation, like an alphabetical telephone listing, was too unoriginal to merit protection, and for the same reasoning that then-Circuit Judge Kennedy had applied to maps. *Id.* 10a (citing *Feist Pubs., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991) and *United States v. Hamilton*, 583 F.2d 448, 451 (CA9 1978)). Any protection Satava might have for his *work of art*, the Ninth Circuit held, was as "thin" as the protection given to factual compilations, and cannot prevent respondents from copying his art as long as they vary their copies slightly from Satava's work (such as by "curl[ing] . . . particular tendrils" a different way). *Id.* 12a-13a.

5. This petition for writ of certiorari followed.

REASONS FOR GRANTING THE PETITION

The petition should be granted for two reasons.

First, the Ninth Circuit's judgment strips artists of copyright protection in the 11 western states for artistic renditions of "animals in their natural surroundings" that a court views as realistic, Pet. App. 13a — and, as practical matter, for any other art that realistically depicts scenes drawn from life or other subject matter in the public doma— while artists elsewhere continue to receive protection for art "drawn from life" under

this Court's decision in *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903), and for art depicting animals under a plethora of lower federal court decisions. The Ninth Circuit's decision conflicts with the holdings of this Court and other circuits not only in this respect, but also in holding that an artist's unprecedented combination of aesthetic elements in a work of art is no more original than a mechanical alphabetical listing of telephone numbers in a directory and hence too unoriginal to merit copyright protection

Second, the Ninth Circuit's decision erroneously incorporates into analysis of art the concept of a "thin" copyright that applies to factual compilations, such as telephone directories and computer codes, when they do receive copyright protection. The theoretical underpinning of the "thin" copyright doctrine — that protection is narrow when the range of potential expression is narrow — has no application to art because, as Justice Holmes' observed in *Bleistein*, every artist's rendition is different, and thus the range of potential expression is virtually limitless. That is especially true when applied to jellyfish, which the district court expressly found "exist in a wide variety of forms, sizes, shapes, and colors," Pet. App. 16a n.3, but has been applied by other circuits to animals, such as deer, that appear in nature in more limited variety than jellyfish. The Ninth Circuit's decision thus conflicts with these decisions of this Court and other circuits in a manner that will sow confusion in copyright law and also erode copyright protection for art.

I. Certiorari Is Warranted Because The Decision Strips Artists of Copyright Protection For Art Drawn From Life And Thus Conflicts With Decisions Of This Court And Of Other Circuits

In light of the express protections afforded "pictorial, graphic, and sculptural works" by the Copyright Act, 17 U.S.C. § 102(a)(5) — and the underlying purpose of the Act and Copyright Clause of the Constitution to "encourage[] . . . the

production of literary [and artistic] works of lasting benefit," *Mazer v. Stein*, 347 U.S. 201, 219 (1954) (brackets in original, internal quotation omitted) – this Court has long recognized the importance of accepting for review decisions that would deny "enforceable rights to authors [and artists]," *id.* (brackets added), by taking an unduly narrow view of what art is entitled to copyright protection.

Thus in *Bleistein*, this Court accepted for review and reversed a decision of the Court of Appeals that denied copyright protection for lithographs depicting circus scenes "drawn from life" because, *inter alia*, an artist's personal expression of such scenes "always contains something unique." 188 U.S. at 249-50. As Justice Holmes wrote for the Court, "[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits." *Id.* at 251. In *Mazur*, this Court granted certiorari to resolve a conflict between the circuits as to whether "statuettes of male and female dancing figures" used as lamp bases were protectable, 347 U.S. at 202-03, and said *Bleistein*, among other decisions, compelled the conclusion that the statuettes were sufficiently original to merit copyright protection. *Id.* at 214 & n.30. As long as the art is "original" in the sense that it constitutes "the author's tangible expression of his ideas," it is entitled to copyright protection "whether meticulously delineating the model or mental image or conveying the meaning by modernistic form or color." *Id.* Both decisions drew on *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884), in which the Court affirmed copyright protection for a photograph of Oscar Wilde as "an original work of art" because it reflected the artist's selection and arrangement of the subject and other items in the photograph. *Id.* at 59-60.

Without citing any of these decisions, the Ninth Circuit held that Satava's glass-in-glass sculptures of jellyfish were not sufficiently original to merit copyright protection for two

reasons. *First*, the Ninth Circuit concluded that realistic sculptures of animals "are composed of unprotectable ideas and standard elements" on the theory that they depict "animals in their natural surroundings,"[2] which is "part of the public domain." *Id.* 3a, 9a, 13a. *Second*, the Ninth Circuit concluded that Satava's work of art as a whole, his combination of elements, was not "original enough" to merit copyright protection, *id.* 10a, even though the record below showed no artist before Satava had combined these elements in this fashion. Certiorari should be granted because both holdings conflict with holdings of this Court and of other circuits, and deprive artists of copyright protection for art deemed by judges to be too "realistic" or "lifelike."

A. The Ninth Circuit's Decision Conflicts With The Holdings Of This Court And Other Circuits That Realistic Artistic Renditions Of Animals And Other Scenes Drawn From Life Are Entitled To Copyright Protection

The Ninth Circuit mistakenly posited the dispositive question as "whether an artist's lifelike glass-in-glass sculptures of jellyfish are protectable by copyright." Pet. App. 2a. It then concluded that artists' "lifelike" renditions of animals are not protectable on the apparent theory that depicting an animal as it appears in life is akin to attempting to copyright an idea, which is unprotectable. 17 U.S.C. § 102(b); *see* Pet. App. 13a ("Nature gives us ideas of animals in their natural surroundings. . . . These ideas, first expressed by nature, are the common heritage of humankind."); *id.* 9a ("These elements are part of the public domain. They are the common property of all, and Satava may not use copyright law to seize them for his exclusive use.").

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[2] The Ninth Circuit found *clear* glass was "the most appropriate setting for an aquatic animal." Pet. App. 9a. However, there is no evidence in the record to support finding clear glass more appropriate for depicting aquatic animals than blue glass, which other artists use as a setting for jellyfish in their natural aquatic surroundings. ER 245.

In both posing this question, and in formulating its answer, the Ninth Circuit erred in a manner that squarely conflicts with prior decisions of this Court and other circuits. Indeed, this Court itself has expressly instructed that protection for art does not turn on whether it depicts scenes "drawn from life." *Bleistein*, 188 U.S. at 249. In holding circus posters to be protectable, the Court in *Bleistein* rejected defendant's argument that the posters were not protectable because they depicted scenes at the circus. *Id.* Writing for the Court, Justice Holmes articulated why that fact, "if it be one," did not deprive the art of copyright protection:

> They [the lithographs] seem from testimony to have been composed from hints or description, not from sight of a performance. *But even if they had been drawn from life, that fact would not deprive them of protection.* The opposite proposition would mean that a portrait by Velasquez or Whistler was common property because others might try their hand on the same face. *Others are free to copy the original. They are not free to copy the copy. . . . The copy is the personal reaction of an individual upon nature. Personality always contains something unique.* It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible, which is one man's alone. That something he may copyright. . . .

Id. at 249-50 (citations omitted and emphasis added).

It is evident that the Ninth Circuit's test for copyright involving "realistic" art (depicting animals or other scenes "drawn from life") cannot be squared with the rule stated in *Bleistein*.

As a threshold matter, *Bleistein* makes clear that the focus never should have been, as the Ninth Circuit made it, on the protectability *vel non* of Satava's sculptures. Rather, the question

the Ninth Circuit should have asked, but did not, was whether respondents' sculptures constitute a "copy of the original" — *i.e.*, merely reflect the same idea of a jellyfish — or, as the district court found, "copy the copy." At least two Courts of Appeals have recognized that *Bleistein* compels this approach to animal-based art,[3] while a third recognized that *Bleistein* compels this approach with respect to art that is said to reproduce elements "in the public domain."[4] By erroneously shifting the focus off the defendant to the protectability of a plaintiff's artistic rendition of an animal, and taking a narrow view of that protectability on the theory that animals are in the public domain, *see* Pet. App. 9a, the Ninth Circuit's decision conflicts with *Bleistein* and the decisions in the Second, Third and Fourth Circuits cited in the margin, and, as a practical matter, creates a separate standard for protectability that will greatly undermine copyright protection for art in the Ninth Circuit and will encourage blatant infringement of any art "drawn from life."

The extent to which the Ninth Circuit's decision creates dual and wildly disparate systems of protectability is aptly

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[3] *See Masquerade Novelty, Inc. v. Unique Industries, Inc.*, 912 F.2d 663, 671 (CA3 1990) ("On remand, it will be [plaintiff's] burden to show that [defendant's] [animal] nose masks incorporate copies, in the copyright law sense, of [plaintiff's] sculptures, rather than sculptures that derive their similarity to [plaintiff's] sculptures merely from the commonality of the animal subjects both represent.") (citing *Bleistein*, 188 U.S. at 249); *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488, 492 (CA4 1996) ("[W]hile authors are free to adopt ideas, narrate facts, and copy an original, they are not free 'to copy the copy.'") (animal mannequins) (quoting *Bleistein*, 188 U.S. at 249).

[4] *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 104-05 (CA2 1951) ("We consider untenable defendants' suggestion that plaintiff's mezzotints could not validly be copyrighted because they are reproductions of works in the public domain. . . . [D]efendants' arguments about the public domain" would "be relevant only in their bearing on the issue of infringement, *i.e.*, whether the defendants copied the mezzotints.") (citing *Bleistein*, 188 U.S. at 250).

illustrated by cases in at least five other circuits whose holdings conflict with the Ninth Circuit's conclusion that animal-based art is not protectable. In the First Circuit, an artist is entitled to copyright protection for "his own version of a 'realistic-looking'" animal sculpture;[5] in the Second, there is "little doubt as to the validity of plaintiff's copyright" in an animal sculpture, even if it is based on a "live model" of the animal;[6] in the Third, the artist has protection for "relatively straightforward representations of animal" features;[7] in the Fourth, "an animal sculpture, even if realistic, is copyrightable as long as the work represents the author's creative effort,"[8] and a district court in the Sixth Circuit recently *rejected* the argument that such art is "too realistic to constitute an original expression subject to copyright protection."[9] Even a prior decision in the Ninth Circuit

[5] *Concrete Machinery Co. v. Classic Lawn Ornaments*, 843 F.2d 600, 607-08 (CA1 1988):

> [A]ppellant has a copyright in a design of a concrete "life size deer." The idea behind this particular expression can be briefly described as a "realistic-looking concrete deer." Appellant cannot prohibit others from appropriating this idea; it can, however, prohibit any actual copying of its own version of a "realistic-looking concrete deer."

[6] *Rushton v. Vitale*, 218 F.2d 434, 435-36 (CA2 1955) ("The mere fact that [chimpanzee dolls] were based on live models does not deprive them of the necessary amount of originality."); *see also Knitwaves v. Lollytogs Ltd.*, 71 F.3d 996 (CA2 1995) (squirrel and leaf design protectable).

[7] *Masquerade Novelty*, 912 F.2d at 671 (animal nose sculptures); *see also Albert E. Price v. Metzner*, 574 F. Supp. 281, 287 (E.D. Pa. 1983) (enjoining "wood duck card boxes" that copied plaintiff's "expression" of a duck because "[w]orks based on live animals and depicting live animals are copyrightable").

[8] *Superior Form Builders*, 74 F.3d at 492 (animal mannequins).

[9] *Cannon Group, Inc. v. Better Bags, Inc.*, 250 F. Supp. 2d 893, 901 (S.D. Ohio 2003) ("The drawing of ears of corn on BBI's header bags possess at least the requisite amount of creativity for copyright protection.").

"rejected" the proposition underlying the decision in this case that "realistic depictions of live animals are not copyrightable."[10]

Aside from the prior Ninth Circuit opinion, the decision in this case did not discuss *any* of these cases finding animal art to be protectable and placing the focus of the infringement analysis on whether defendant's work copied the plaintiff's art. —Nor did it recognize or address the controlling authority of *Bleistein*. This is no mere semantical shortcoming, or another way to reach the same result, but rather a mistake that will have profound impact on artists and the law.

Under *Bleistein* and its progeny, each individual case of alleged infringement is evaluated on its own merit to determine whether the defendant's art copied plaintiff's rendition of the animal (or any other scene "drawn from life") or merely contains the same subject matter without copying plaintiff. A defense verdict in one case does not deprive the plaintiff of protection from infringement in the next, nor deprive all artists of protection for similar genres of art. But under the decision in this case, courts in the Ninth Circuit will not even reach the question of whether the defendant copied the plaintiff. Rather, the dispositive question will become whether the court, in the exercise of its

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[10] *Kamar Int'l v. Russ Berrie & Co.*, 657 F.2d 1059, 1061 (CA9 1981):

> [Defendant] makes the novel contention that realistic depictions of live animals are not copyrightable. . . . We find no authority for [that] proposition. . . . Indeed, the very contention urged has been expressly rejected. "The mere fact that . . . [a stuffed toy chimp is] based on a live model does not deprive [him] . . . of the necessary amount of originality. *Rushton v. Vitale*, 218 F.2d 434, 436 (2d Cir. 1955); *see also, Dollcraft Industries, Inc. v. Well-Made Toy Mfg*, 479 F. Supp. 1105 (E.D.N.Y. 1978) (stuffed toy lambs and bunnies; *R. Dakin & Co. v. A & L Novelty Co., Inc.*, [444 F. Supp. 1080 (E.D.N.Y. 1978)] (stuffed toy fish, frogs, and monkeys)."

artistic judgment, considers plaintiff's art to be a "lifelike" or "realistic" depiction of an "animal[] in [its] natural surroundings." If so, the presumptions will be reversed — from original and copyrightable, in the case of a timely registered work, *see* 17 U.S.C. § 410(c); *Boisson v. American County Quilts and Linens, Inc.*, 273 F.3d 262, 268 (CA2 2001), to unprotectable. A defense verdict in one case will deprive plaintiff of the ability to protect his or her art from future infringement — and deprive all artists of meaningful protection for similar art. Many instances of even blatant copying will go unpunished — indeed, unchallenged — which will inevitably discourage "artistic creativity," and the enormous time and effort necessary for painstaking renditions of animals or other scenes drawn from life, if the artists know they cannot protect their ability to "secure a fair return for [their] creative labor." *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975).

The Ninth Circuit cannot forestall these repercussions, nor the need for this Court's intervention, by saying at the end of its decision that it did not mean to hold — as it already had — that animal-based art is not protectable, only that this protection is too "thin" to offer any meaningful protection. Pet App. 12a. The two district courts that have cited the Ninth Circuit's decision to date have read it to support findings that plaintiff's work was not protectable in one case,[11] and that plaintiffs' combination of elements was not protectable in the other.[12] This

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[11] *Osvaldo Garcia-Goyco v. Puerto Rico Highway Authority*, 2003 U.S. Dist. LEXIS 13460, at *23 (D.P.R., Apr. 30, 2003) ("Expressions in the public domain may not be monopolized by mere copyright registration.") (citing and then quoting Pet. App. 21).

[12] *Cottrill v. Spears*, 2003 U.S. Dist. LEXIS 8823, at *33 (E.D. Pa. May 22, 2003) ("While some courts hold that a combination of unprotectable elements may qualify for copyright protection, . . . those elements must be 'numerous enough and their selection and arrangement original enough that their combination constitutes an original of authorship.' . . . The same cannot be said of the elements here. . . .") (quoting Pet. App. 10a).

is hardly surprising, since the Ninth Circuit starts its decision by posing the sole question to be decided as "whether an artist's lifelike glass-in-glass sculptures of jellyfish are protectable," Pet. App. 2a, and never mentions nor applies the test for infringement (access and substantial similarity). The only conclusion that can be drawn is the one the district courts are already drawing — that the decision limits copyright protection at the threshold, in sharp conflict with the precedent of this Court and other circuits. In any event, as explained below, even the Ninth Circuit's attempt to limit its holding erred in a manner that conflicts with *Bleistein* and other precedent by restricting artists' protection for animal-based art (and all art "drawn from life") to only their "variations" on the lifelike, Pet. App. 12a, so that artists have little if any protection for "realistic" art and no protection at all for their art as a whole (*i.e.*, as a combination of elements).

B. The Ninth Circuit's Decision Also Conflicts With The Holdings Of This Court And Other Circuits That Works Of Art As A Whole — As An Artist's Original Combination Of Elements — Is Entitled To Copyright Protection

The second part of the Ninth Circuit's core holding dispels any doubt that it is stripping Satava of protection. The decision expressly holds that his work of art, considered as a whole — *i.e.*, as artistic selection, combination and arrangement of elements — "lacks the quantum of originality needed to merit copyright protection." Pet. App. 10a. As far as Satava can determine, this holding is unprecedented as applied to art. The decision cites no art cases to support its holding, but instead misapplies a prior Ninth Circuit case involving maps, *United States v. Hamilton*, 583 F.2d 448 (9th Cir. 1978) (per Kennedy, J.), and a decision of this Court involving telephone directories. *Feist Pubs., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991).

In misapplying the rule of *Feist* — that the mechanical arrangement of phone numbers in a directory was too "'unoriginal'" to merit copyright protection — to strip a work of sculptural art of its copyright protection, Pet. App. 11a (quoting *Feist*, 499 U.S. at 363), the Ninth Circuit's decision cannot be reconciled with the distinction drawn in *Bleistein* that even "[t]he least pretentious picture has more originality in it than directories and the like." 188 U.S. at 250. With respect to the circus posters at issue in that case, *Bleistein* found "no reason to doubt that these prints in the *ensemble* and in all their details, in their design and *particular combination of figures, lines, and colors*, are the original work of the plaintiffs' designer." *Id.* (second emphasis added). In light its recognition that even the most "modest grade of art" is original enough to merit protection, *id.*, Judge Learned Hand read Justice Holmes' opinion to mean that any photograph, "however simple," is sufficiently original to warrant protection. *Jeweler' Circular Pub. Co. v. Keystone Pub. Co.*, 274 F. 932, 934 (S.D.N.Y. 1921) ("*Burrow-Giles Co. v. Sarony* . . . left open an intimation that some photographs might not be protected. . . . I think that . . . *Bleistein* . . . rules, because no photograph, however simple, can be unaffected by the personal influence of the author, and no two will be absolutely alike."). Nothing in *Bleistein* or *Feist* suggests or allows a different, more stringent, rule or result for other works of art.

As this Court has recognized, *Feist* itself "contrast[ed] creative works with bare factual compilations," *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 586 (1994) (citing *Feist*, 499 U.S. at 348-51), and held only that a mechanical compilation of otherwise-unprotectable "facts" — telephone numbers listed alphabetically by surname – was not sufficiently original to merit protection because it was utterly "devoid of even the slightest trace of creativity." *Feist*, 499 U.S. at 362. Indeed, the language and analysis of *Feist* strongly suggests that, while "there will be some *fact-based works* in which the selection, coordination, and arrangement [of facts] are not sufficiently original to trigger

copyright protection," *id.* at 358 (emphasis added), works of art do *not* fall within the "narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent," *id.* at 359, because the combination of elements in art reflects at least the "modicum" or "minimal degree of creativity" necessary to establish originality. *Id.* at 345, 348. As *Feist* explained, the "requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, 'no matter how crude, humble or obvious' it might be." *Id.* at 345 (citation omitted). "Originality requires only that the author makes the selection or arrangement independently (i.e., without copyright that selection or arrangement from another work), and that it display some minimal level of creativity." *Id.* at 358.

Considered in light of *Bleistein*'s recognition that a work of art "*always* contains something unique" to the artist, 188 U.S. at 250, it is inconceivable that this Court intended *Feist* to be used to deny copyright protection to the combination of elements (even otherwise-unprotectable elements) in a work of art. This is all the more true here, where the record shows the artist's combination of these elements was not only original but novel, in that no other artist had previously combined all these same elements in the same fashion.

It is not surprising, then, that Savata has been unable to find any other decision that has applied *Feist* to deprive an artist of copyright protection. On the other hand, the Second Circuit has concluded that copyright protection for a work of art or design as a whole — for its "total concept and feel" — is "a necessary result of the Supreme Court's statement in *Feist*, 499 U.S. at 350, 361-64, that compilations of unprotectible elements merit copyright protection insofar as they contain an original and non-mechanical selection, coordination or arrangement of those elements." *Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc.*, __ F.3d __, 2003 U.S.

App. LEXIS 15064, at *17 n.7 (CA2 July 30, 2003).[13] And the Fourth Circuit has read *Feist* to meant that animal sculptures "inevitably possess some degree of originality," save only the rare (and inapplicable here) circumstance where someone simply "makes a casting rather than a sculpture of the deer" or other animal subject. *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488, 493 (CA4 1996).[14] The Ninth Circuit's misreading of *Feist* simply cannot be reconciled with these circuits' reading of *Feist*, nor with *Feist* and *Bleistein* themselves or the other decisions that have accorded copyright protection to the combination of otherwise-unprotectable elements in works of art.[15]

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[13] Citing *Boisson v. Banian, Ltd.*, 273 F.3d 262, 272-73 (CA2 2001); *Knitwaves*, 71 F.3d at 1003-04; and *Streetwise Maps, Inc. v. Byer Cal.*, 937 F.2d 759, 748 (CA2 1998).

[14] Under *Feist*, an animal sculptor's

> individual creative efforts inevitably possess some degree of originality. . . . If, however, a person makes a casting rather than a sculpture of the deer, the effort introduces no originality into the product. Indeed, in such a case, the idea in the original and its expression in the casting are identical and inseparable because the mechanical process allowed for no possibility of originality, which is inherent in authorship.

Superior Form Builders, 74 F.3d at 492-93.

[15] *See, e.g., Boisson*, 273 F.3d at 269 (plaintiff's layout and combination of letters from the alphabet, which individually are in the public domain, is original and protectable); *Roulo v. Russ Berrie & Co.*, 886 F.2d 931, 940 (CA7 1989) (plaintiff's "copyright is in the artistic combination of all the common elements previously described"); *Metcalf v. Bochco*, 294 F.3d 1069, 1074 (CA9 2002) (plaintiff's "original selection and arrangement of unprotected elements'" protectable); *Sturdaza v. United Arab Emirates*, 281 F.3d 1287, 1299 (CADC 2002) (defendants' "combination of these elements" infringed plaintiff's combination); *Runstadler Studios, Inc. v. MCM Ltd.*, 768 F. Supp. 1292, 1295 (N.D. Ill. 1991) (*rejecting* claim that art was "lacking in creativity because the sculpture is simply a combination of uncopyrightable standard shapes").

It is no overstatement to recognize the devastating impact the Ninth Circuit's decision will have on artists throughout the Ninth Circuit and beyond.[16] If allowed to stand, the Ninth Circuit's decision will eviscerate copyright protection for many "realistic" works of art, especially animal-based art, both in their constituent elements and for the works as an aesthetic whole — *i.e.*, as a combination of elements (which is, after all, how most patrons relate to and appreciate works of art). It will allow appellate judges to substitute their artistic views for the factual findings of the district court with respect to the protectability of the constituent elements — even where, as here, the appellate court could not and did not determine those findings to be clearly erroneous — and then compound that mistake by making the value judgment that the "quantum of originality" underlying the artist's aesthetic decisions to combine those elements was too "'trivial'" to merit copyright protection, Pet. App. 11a, even where the record reflects that no prior artist had ever combined all those elements in this fashion. In the most celebrated passage of his *Bleistein* opinion, Justice Holmes warned long ago of the dangers inherent in allowing artists' copyright protection to turn on such judicial evaluations of their art:

> It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme, some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time.

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[16] As noted above, one court in the Third Circuit has already applied the Ninth Circuit's decision to support finding the combination of elements in a song did not merit copyright protection. *Cottrill v. Spears*, 2003 U.S. Dist. LEXIS 8823, at *33 (E.D. Pa. May 22, 2003).

> At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public . . . — it would be bold to say that they have not an aesthetic and educational value — and the taste of any public is not to be treated with contempt.

Bleistein, 188 U.S. at 251-52; *see also Campbell v. Acuff-Rose Music*, 510 U.S. 569, 582-83 (1994) (quoting this passage from *Bleistein*). Unless this Court intercedes, the Ninth Circuit's decision will encourage judges to ignore, as the Ninth Circuit did, this Court's warnings in *Bleistein* and *Campbell* and instead impose their own aesthetic judgment as to whether an artist's combination of elements, his or her work as a whole, creates something the judges value enough to deem it sufficiently original to merit copyright protection.[17]

II. Certiorari Also Is Warranted Because The Decision Erroneously Limits Copyright Protection For "Realistic" Art By Applying The "Thin" Copyright Doctrine Reserved For Factual Works, In Conflict With Decisions Of This Court And Of Other Circuits

At the end of its decision, the Ninth Circuit asserted, in the face of circuit precedent so holding, that it was not denying copyright protection to "realistic depictions of live animals,"

[17] The Ninth Circuit mistakenly thought that "[t]o give Satava a copyright on this basic combination of elements would effectively give him a monopoly on the idea of glass-in-glass sculptures of single vertical jellyfish." Pet. App. 10a-11a. This is not so, for it confuses copyright protection with infringement, which still must be proven. *See, e.g., Bleistein*, 188 U.S. at 249; *Masquerade Novelty*, 912 F.2d at 671; *Concrete Machinery*, 843 F.2d at 607. That is why, out of the "dozens of photographs of glass-in-glass sculptures in the record," Pet. App. 11a n.5, including many made by respondents that are also of "single vertical jellyfish," Satava only sought to enjoin respondents' sculptures that combined the same elements in a substantially similar manner.

Pet. App. 12a (citing *Kamar Int'l v. Russ Berrie and Co.*, 657 F.2d 1059, 1061 (CA9 1981)), only holding that any protection was "thin." Pet. App. 12a. It is difficult to know what to make of this assertion in light of the holdings earlier in its decision that the various elements that make up Satava's work were unprotectable, *id.* 3a, and that Satava's work as a whole, his combination of those elements the Ninth Circuit had determined to be unprotectable, also "lacks the quantum of originality needed to merit copyright protection." *Id.* 10a. Having already found Satava's lifelike rendition of a jellyfish to be unprotectable, the Ninth Circuit's attempt to disclaim any intent to deprive such art of copyright protection rings hollow.

Even taken at face value, this part of the decision dramatically shrinks the protection afforded to art that a judge may view as a "realistic" depiction of an animal or other scenes drawn from life, and does so in a way that cannot be squared with *Bleistein* or decisions from other circuits. In the Ninth Circuit's view, an artist's protection for a realistic depiction of an animal or other scene drawn from life is as "thin" as the limited protection given to a factual compilation or software code. Pet. App. 12a. In the Ninth Circuit's view, this protection extends only to the ways in which artists "*vary*" their rendition from the way animals actually appear in life. *Id* 12a-13a.[18]

[18] Satava "has made some copyrightable contributions: the distinctive curls of particular tendrils; the arrangement of certain hues; the unique shape of jellyfish bells." Pet. App. 12a.

> An artist may . . . protect [such] original expression he or she contributes to these ideas. An artist may vary the pose, attitude, gesture, muscle structure, facial expression, coat, or texture of animal. An artist may vary the background, lighting, or perspective. Such variations, if original, may earn copyright protection. Because Satava's jellyfish sculptures contain few variations of this type, the scope of his copyright protection is narrow.

Id. 13a.

Taken literally, an artist's rendition of the animal or person or any other item (a Campbell's Soup can, for example) said to be "in the public domain" would be largely unprotectable if considered by the court to be entirely realistic, and only protectable to the extent it is thought by a court to "vary" from the lifelike. *Id.* Apparently, all the artist can prevent is "virtually identical copying" that incorporates all the same variations added by the artist; if the infringer slightly varies his copy — *e.g.*, "curls . . . [a] particular tendril[]" a different way, *id.* 12a — the artist is powerless to prevent the copying.

There are at least two fatal flaws in this part of the Ninth Circuit's analysis that will, unless corrected by this Court, sow analytic confusion and curtail copyright protection for "realistic" art.

First, the concept of a "thin" copyright derives from cases involving such factual compilations as telephone directories or incremental advances in computer source code built on existing code, *see, e.g., Feist*, 499 U.S. at 349 ("This inevitably means that the copyright in a factual compilation is thin."), and does not extend to art.[19] The theoretical underpinning of the "thin" copyright doctrine is that, "[w]hen the range of protectable expression is narrow, the appropriate standard for illicit copying is virtual identity." *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1439 (CA9 1994) (quoted in Pet. App. 12a). That concept has no application to most art; as Justice Holmes

[19] This is consistent with the authorities recognizing that, in the extrinsic part of the substantial similarity analysis, the sort of analysis used to "dissect" literary works and computer software, and thus to narrow the scope of their copyright protection, "do[es] not readily apply to art works." *Cavalier v. Random House*, 297 F.3d 815, 826 (CA9 2002); *Knitwaves*, 71 F.3d at 1003-04 (refusing to conduct analytic dissection before comparing the "total concept and feel" of the parties' squirrel and leaf designs); M. Nimmer & D. Nimmer, *Nimmer on Copyright* § 13.03[A][1][c] ("simplistic works," like works of visual art, "require only a highly 'instrinsic' (*i.e.*, unanalytic) evaluation").

recognized, each artist's rendition of even mundane subject matter is "personal," and hence different, so the range of potential expression of an animal or other scene "drawn from life" is infinite. *Bleistein*, 188 U.S. at 249-50.

Here, for example, the Ninth Circuit mistakenly thought jellyfish features take only limited forms in nature, and thus it thought the range for artistic expressions of jellyfish in glass art was narrow. Pet App. 8a-9a. Not only were both suppositions inconsistent with factual findings of the district court that the Ninth Circuit never acknowledged nor addressed,[20] they confused the *subject matter* of the art with the artist's personal rendition of that subject. To say that an artist cannot protect the "realistic" or "lifelike" portions of his or her rendition of a jellyfish (or cannot protect them from copies that vary slightly from the artist's original) on the theory that jellyfish are in the public domain and thus free for all to copy, not only overlooks the critical distinction between art and its subject but also conflicts with precedent.[21] Even with respect to deer, which take essentially one form in nature, several other circuits have recognized that each artists' rendition of the deer is protectable,

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[20] "Jellyfish exist in a wide variety of forms, sizes, shapes, and colors." Pet App. 16a. "Other artists have created a wide variety of glass art depicting jellyfish, . . . representing jellyfish in a wide range of colors, positions, and shapes." *Id.* 21a.

[21] Even "a painstakingly detailed reproduction of an object in the public domain may receive copyright protection," *Concrete Machinery Co.*, 843 F.2d at 607, and "[s]light or trivial variations between works will not preclude a finding of infringement." *Id.* at 608; *see also, e.g., Knitwaves*, 71 F.3d at 1004 (affirming finding that defendant's Leaf and Squirrel sweaters infringed plaintiff's copyright, despite defendant' "lengthy recitation of differences" between the works, "[g]iven the overwhelming similarity of the sweaters' 'total concept and feel'"); *Masquerade Novelty*, 912 F.2d at 671-72 (finding realistic animal masks protectable and remanding on the issue of infringement) and 1990 U.S. Dist. LEXIS 16980, at *17 (E.D. Pa. 1990) (finding infringement on remand despite "differences in size, coloration and finish").

and the protection is not "thin," but the artist must prove as part of the substantial similarity analysis that the defendant copied the artist's expression of a deer rather than a deer itself. *Superior Form Builders*, 74 F.3d at 492 ("Several sculptors may copy a deer, even the same deer, in creating a sculpture, and each may obtain copyright protection for his or her own expression of the original."); *Concrete Machinery Co.*, 843 F.2d at 607 ("Appellant cannot prohibit others from appropriating this idea; it can, however, prohibit any actual copying of its own version of a 'realistic-looking concrete deer.'"); *see Bleistein*, 188 U.S. at 249 ("Others are free to copy the original. They are not free to copy the copy.").

Second, by applying the wrong precedent and analysis, the Ninth Circuit reached the wrong result, one foursquare at odds with *Bleistein*, and stripped "realistic" art of much if not all of its copyright protection. To take the example Justice Holmes cited in *Bleistein*, under the Ninth Circuit's approach Whistler would be unable to protect his rendition of his mother except to the extent that he had varied her appearance in some way, or the background, lighting, and perspective. No doubt Whistler would have found such protection to be of little comfort, for the copier would be free to steal the essence of his portrait while altering slightly the background or other variations Whistler had added. Certainly, Justice Holmes did not envision so narrow a protection for art "drawn from life." *Bleistein*, 188 U.S. at 249 (recognizing that the proposition ultimately adopted by the Ninth Circuit in this case "would mean that a portrait by Velasquez or Whistler was common property because others might try their hand on the same face"). To prevent such a result, other circuits recognize the importance of comparing the "total concept and feel" of the parties' art as part of the substantial similarity analysis to determine if the defendant had copied plaintiff's rendition,[22] but the Ninth Circuit's decision negates that protection by

[22] *See, e.g., Tufenkian Import/Export Ventures*, __ F.3d __, 2003 U.S. App. LEXIS 15064, at *17 & n.7 (citing cases).

holding "realistic" art to be beyond meaningful copyright protection — or any protection at all for the work as a whole — as a threshold matter.

CONCLUSION

For all the foregoing reasons, Petitioners Richard Satava and Satava Art Glass respectfully urge this Court to safeguard the copyright protection and livelihood of artists who create "realistic" art that depicts animals and other scenes drawn from life by granting their petition for a writ of certiorari in this case.

Respectfully submitted,

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APPENDIX

APPENDIX A — OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT FILED MARCH 20, 2003

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

No. 02-16347

D.C. No.
CV-01-00701-GEB

RICHARD SATAVA, an individual; SATAVA ART GLASS,
a sole proprietorship,

Plaintiffs-Appellees,

v.

CHRISTOPHER LOWRY, an individual; CHRISTOPHER RICHARDS,
an individual; MAKAWAO GLASSWORKS, LLC,
dba Hot Island Glass,

Defendants-Appellants.

Appeal from the United States District Court
for the Eastern District of California
Garland E. Burrell, District Judge, Presiding

Argued and Submitted
February 10, 2003—San Francisco, California

Filed March 20, 2003

Appendix A

Before: Barry G. Silverman and Ronald M. Gould, Circuit Judges, and Charles R. Weiner,* Senior District Judge.

Opinion by Judge Gould

OPINION

GOULD, Circuit Judge:

In the Copyright Act, Congress sought to benefit the public by encouraging artists' creative expression. Congress carefully drew the contours of copyright protection to achieve this goal. It granted artists the exclusive right to the original expression in their works, thereby giving them a financial incentive to create works to enrich our culture.[1] But it denied artists the exclusive right to ideas and standard elements in their works, thereby preventing them from monopolizing what rightfully belongs to the public. In this case, we must locate the faint line between unprotected idea and original expression in the context of realistic animal sculpture. We must decide whether an artist's lifelike glass-in-glass sculptures of jellyfish are protectable by copyright.

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* The Honorable Charles R. Weiner, Senior United States District Judge for Eastern Pennsylvania, sitting by designation.

1. Justice Potter Stewart explained this feature of copyright law: "The immediate effect of our copyright law is to secure a fair return for an 'author's' creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good." *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975).

Appendix A

Because we conclude that the sculptures are composed of unprotectable ideas and standard elements, and also that the combination of those unprotectable elements is unprotectable, we reverse the judgment of the district court.

I

Plaintiff Richard Satava is a glass artist from California. In the late 1980s, Satava was inspired by the jellyfish display at an aquarium. He began experimenting with jellyfish sculptures in the glass-in-glass medium and, in 1990, began selling glass-in-glass jellyfish sculptures. The sculptures sold well, and Satava made more of them. By 2002, Satava was designing and creating about three hundred jellyfish sculptures each month. Satava's sculptures are sold in galleries and gift shops in forty states, and they sell for hundreds or thousands of dollars, depending on size. Satava has registered several of his works with the Register of Copyrights.

Satava describes his sculptures as "vertically oriented, colorful, fanciful jellyfish with tendril-like tentacles and a rounded bell encased in an outer layer of rounded clear glass that is bulbous at the top and tapering toward the bottom to form roughly a bullet shape, with the jellyfish portion of the sculpture filling almost the entire volume of the outer, clearglass shroud." Satava's jellyfish appear lifelike. They resemble the *pelagia colorata* that live in the Pacific Ocean:

Appendix A

During the 1990s, defendant Christopher Lowry, a glass artist from Hawaii, also began making glass-in-glass jellyfish

sculptures. Lowry's sculptures look like Satava's, and many people confuse them:

Appendix A

In Hawaii, Satava's sculptures have appeared in tourist brochures and art magazines. The sculptures are sold in sixteen galleries and gift shops, and they appear in many store windows. Lowry admits he saw a picture of Satava's jellyfish sculptures in *American Craft* magazine in 1996. And he admits he examined a Satava jellyfish sculpture that a customer brought him for repair in 1997.

Glass-in-glass sculpture is a centuries-old art form that consists of a glass sculpture inside a second glass layer, commonly called the shroud. The artist creates an inner glass sculpture and then dips it into molten glass, encasing it in a solid outer glass shroud. The shroud is malleable before it cools, and the artist can manipulate it into any shape he or she desires.

Satava filed suit against Lowry accusing him of copyright infringement. Satava requested, and the district court granted, a preliminary injunction, enjoining Lowry from making sculptures that resemble Satava's.[2] Lowry appealed to us.

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2. The injunction prevented Lowry from making or selling sculptures with "a vertically oriented, colorful, fanciful jellyfish with tendril-like tentacles and a rounded bell encased in an outer layer of rounded clear glass that is bulbous at the top and tapering toward the bottom to form roughly a bullet shape, with the jellyfish portion of the sculpture filling almost the entire volume of the outer, clear glass shroud."

Appendix A

II

A preliminary injunction must be affirmed on appeal unless the district court (1) abused its discretion or (2) based its decision on an erroneous legal standard or on clearly erroneous findings of fact. *United States v. Peninsula Communications, Inc.*, 287 F.3d 832, 839 (9th Cir. 2002). We hold that the district court based its decision on an erroneous legal standard, so we reverse.

Copyright protection is available for "original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device." 17 U.S.C. § 102(a). Copyright protection does not, however, "extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery. . . ." 17 U.S.C. § 102(b).

[1] Any copyrighted expression must be "original." *Feist Pubs., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). Although the amount of creative input by the author required to meet the originality standard is low, it is not negligible. *See Feist*, 499 U.S. at 362. There must be something more than a "merely trivial" variation, something recognizably the artist's own. *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 489 (9th Cir. 2000).

[2] The originality requirement mandates that objective "facts" and ideas are not copyrightable. *Baker v. Selden*, 101 U.S. (11 Otto) 99 (1879); *Feist*, 499 U.S. at 347; *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1109-10

(9th Cir. 1970). Similarly, expressions that are standard, stock, or common to a particular subject matter or medium are not protectable under copyright law.[3] *See v. Durang*, 711 F.2d 141, 143 (9th Cir. 1983).

[3] It follows from these principles that no copyright protection may be afforded to the idea of producing a glass-in-glass jellyfish sculpture or to elements of expression that naturally follow from the idea of such a sculpture. *See Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 901 (9th Cir. 1987) ("No copyright protection may be afforded to the idea of producing stuffed dinosaur toys or to elements of expression that necessarily follow from the idea of such dolls."). Satava may not prevent others from copying aspects of his sculptures resulting from either jellyfish physiology or from their depiction in the glass-in-glass medium. *See id.* ("Appellants therefore may place no reliance upon any similarity in expression resulting from either the physiognomy of dinosaurs or from the nature of stuffed animals.").

[4] Satava may not prevent others from depicting jellyfish with tendril-like tentacles or rounded bells, because many jellyfish possess those body parts. He may not prevent others from depicting jellyfish in bright colors, because many jellyfish are brightly colored. He may not prevent others from

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3. Standard elements sometimes are called "scènes à faire," vaguely French for "scenes which 'must' be done." *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1082 n. 17 (9th Cir. 2000). The Ninth Circuit treats scènes à faire as a defense to infringement rather than as a barrier to copyrightability. *Id. See also Ets-Hokin v. Skyy Spirits, Inc.*, __ F.3d __ (9th Cir. 2003) (reviewing the district court's decision after remand).

depicting jellyfish swimming vertically, because jellyfish swim vertically in nature and often are depicted swimming vertically.[4] *See id.* at 901 n. 1 (noting that a Tyrannosaurus stuffed animal's open mouth was not an element protected by copyright because Tyrannosaurus "was a carnivore and is commonly pictured with its mouth open").

[5] Satava may not prevent others from depicting jellyfish within a clear outer layer of glass, because clear glass is the most appropriate setting for an aquatic animal. *See id.* (noting that a Pterodactyl stuffed animal's depiction as a mobile hanging from the ceiling was not protectable because Pterodactyl "was a winged creature and thus is appropriate for such treatment"). He may not prevent others from depicting jellyfish "almost filling the entire volume" of the outer glass shroud, because such proportion is standard in glass-in-glass sculpture. And he may not prevent others from tapering the shape of their shrouds, because that shape is standard in glass-in-glass sculpture.

[6] Satava's glass-in-glass jellyfish sculptures, though beautiful, combine several unprotectable ideas and standard elements. These elements are part of the public domain. They are the common property of all, and Satava may not use copyright law to seize them for his exclusive use.

It is true, of course, that a *combination* of unprotectable elements may qualify for copyright protection. *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1446

4. Vertical orientation is a standard element partly because human beings prefer the world right-side-up.

(9th Cir. 1994); *United States v. Hamilton*, 583 F.2d 448, 451 (9th Cir. 1978) (Kennedy, J.) ("[O]riginality may be found in taking the commonplace and making it into a new combination or arrangement."). *See also Metcalf*, 294 F.3d at 1074 ("The particular sequence in which an author strings a significant number of unprotectable elements can itself be a protectable element. Each note in a scale, for example, is not protectable, but a pattern of notes in a tune may earn copyright protection."). But it is not true that *any* combination of unprotectable elements automatically qualifies for copyright protection. Our case law suggests, and we hold today, that a combination of unprotectable elements is eligible for copyright protection only if those elements are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship. *See Metcalf*, 294 F.3d at 1074; *Apple Computer, Inc.*, 35 F.3d at 1446. *See also Feist*, 499 U.S. at 358. ("[T]he principal focus should be on whether the selection, coordination, and arrangement are sufficiently original to merit protection.").

The combination of unprotectable elements in Satava's sculpture falls short of this standard. The selection of the clear glass, oblong shroud, bright colors, proportion, vertical orientation, and stereotyped jellyfish form, considered together, lacks the quantum of originality needed to merit copyright protection. *See Hamilton*, 583 F.2d at 451 ("Trivial elements of compilation and arrangement, of course, are not copyrightable because they fall below the threshold of originality."). These elements are so commonplace in glass-in-glass sculpture and so typical of jellyfish physiology that to recognize copyright protection in their combination

effectively would give Satava a monopoly on lifelike glass-in-glass sculptures of single jellyfish with vertical tentacles. *See Feist*, 499 U.S. at 363 (noting that the selection, coordination, and arrangement of phone numbers in a directory "is not only unoriginal, it is practically inevitable"). Because the quantum of originality Satava added in combining these standard and stereotyped elements must be considered "trivial" under our case law, Satava cannot prevent other artists from combining them.[5]

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5. We reach this conclusion based in part on our examination of the dozens of photographs of glass-in-glass jellyfish sculptures in the record. Some of the sculptures depict almost colorless jellyfish. Some of the sculptures have spherical shrouds. Some have shrouds encased in opaque black glass with clear windows cut through. Though none of the sculptures are identical, all of them are substantially similar. They differ only insofar as an artist has added or omitted some standard element. To give Satava a copyright on this basic combination of elements would effectively give him a monopoly on the idea of glass-in-glass sculptures of single vertical jellyfish. Congress did not intend for artists to fence off private preserves from within the public domain, and, if we recognized Satava's copyright, we would permit him to do exactly that.

Our analysis above suggests that the "merger doctrine" might apply in this case. Under the merger doctrine, courts will not protect a copyrighted work from infringement if the idea underlying the copyrighted work can be expressed in only one way, lest there be a monopoly on the underlying idea. *CDN Inc. v. Kapes*, 197 F.3d 1256, 1261 (9th Cir. 1999). In light of our holding that Satava cannot prevent other artists from using the standard and stereotyped elements in his sculptures, or the combination of those elements, we find it unnecessary to consider the application of the merger doctrine.

We do not mean to suggest that Satava has added nothing copyrightable to his jellyfish sculptures. He has made some copyrightable contributions: the distinctive curls of particular tendrils; the arrangement of certain hues; the unique shape of jellyfishes' bells. To the extent that these and other artistic choices were not governed by jellyfish physiology or the glass-in-glass medium, they are original elements that Satava theoretically may protect through copyright law. Satava's copyright on these original elements (or their combination) is "thin," however, comprising no more than his original contribution to ideas already in the public domain. Stated another way, Satava may prevent others from copying the original features he contributed, but he may not prevent others from copying elements of expression that nature displays for all observers, or that the glass-in-glass medium suggests to all sculptors. Satava possesses a thin copyright that protects against only virtually identical copying. *See Ets-Hokin*, __ F.3d at __ (9th Cir. 2003) ("When we apply the limiting doctrines, subtracting the unoriginal elements, Ets Hokin is left with . . . a 'thin' copyright, which protects against only virtually identical copying."); *Apple*, 35 F.3d at 1439 ("When the range of protectable expression is narrow, the appropriate standard for illicit copying is virtual identity.").

We do not hold that realistic depictions of live animals cannot be protected by copyright. In fact, we have held to the contrary. *See Kamar Int'l, Inc. v. Russ Berrie and Co.*, 657 F.2d 1059, 1061 (9th Cir. 1981). We recognize, however, that the scope of copyright protection in such works is narrow. *See Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 741 (9th Cir. 1971) ("Any inference of copying based upon similar appearance lost much of its strength because

both [works] were lifelike representations of a natural creature."). Nature gives us ideas of animals in their natural surroundings: an eagle with talons extended to snatch a mouse; a grizzly bear clutching a salmon between its teeth; a butterfly emerging from its cocoon; a wolf howling at the full moon; a jellyfish swimming through tropical waters. These ideas, first expressed by nature, are the common heritage of humankind, and no artist may use copyright law to prevent others from depicting them.

An artist may, however, protect the original expression he or she contributes to these ideas. An artist may vary the pose, attitude, gesture, muscle structure, facial expression, coat, or texture of animal. An artist may vary the background, lighting, or perspective. Such variations, if original, may earn copyright protection. Because Satava's jellyfish sculptures contain few variations of this type, the scope of his copyright is narrow.

We do not mean to short-change the legitimate need of creative artists to protect their original works. After all, copyright law achieves its high purpose of enriching our culture by giving artists a financial incentive to create. But we must be careful in copyright cases not to cheat the public domain. Only by vigorously policing the line between idea and expression can we ensure both that artists receive due reward for their original creations and that proper latitude is granted other artists to make use of ideas that properly belong to us all.

REVERSED.

APPENDIX B — ORDER OF THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF CALIFORNIA DATED JUNE 11, 2002 AND FILED JUNE 12, 2002

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF CALIFORNIA

CIV-S-01-701 GEB/DAD

RICHARD SATAVA, an individual, and
SATAVA ART GLASS, a sole proprietorship,

Plaintiffs,

v.

CHRISTOPHER LOWRY, an individual,
CHRISTOPHER RICHARDS, an individual,
and MAKAWAO GLASSWORKS, LLC
dba HOT ISLAND GLASS,

Defendants.

ORDER[1]

Plaintiffs ("Satava") accuse Defendants of copyright infringement and seek a preliminary injunction under 17 U.S.C. § 502(a), "barring defendants from making and selling certain artistic works (the 'jellyfish copies') up to and through a trial on the merits of this case." Pls.' Notice of Mot. & Mot. for Prelim. Inj. at 1. Defendants counter that Satava has "not

1. This matter was determined to be suitable for decision without oral argument. L.R. 78-230(h). **This Order is not selected for publication.**

shown a reasonable likelihood of success on its copyright infringement claim." Defs.' Opp'n ("Opp'n") at 1. For the reasons discussed below, the motion will be granted.[2]

2. On February 25, Satava requested leave to file additional declarations pursuant to Eastern District Local Rule 43-140(a)(2) which permits a party to file affidavits separately from the motion they support if "accompanied by an affidavit of counsel purporting to show good cause for the separate filing thereof." Since Defendants did not object, the declarations will be considered.

After filing their Opposition on March 15, 2002, on March 25, Defendants requested leave to file depositions and summaries of depositions in support of Defendants Opp'n. Satava objects to this request asserting it is untimely and without good cause. Since the depositions were attended by both sides, the deposition transcripts will be considered but the abstracts are disregarded.

On March 27, 2002, the parties were informed that this matter would be submitted without oral argument. Satava's counsel sent a letter to the Court attempting to persuade the Court to hold oral arguments. This letter was stricken from the record because it failed to comply with Local Rule 7-130. On March 29, 2002, Satava filed a request for reinstatement of the hearing on the motion for a preliminary injunction, or in the alternative, for an opportunity to present actual specimens of works at issue to the court. This request was denied by oversight since the Court did not realize Satava had requested a hearing in a footnote.

Further, Satava also requests leave to file a request for judicial notice of a news report which aired April 5, 2002, which depicts Satava's art as well as glass jellyfish sculptures by other artists. Satava asserts this evidence is necessary to support Satava's position that Defendants' copying is not excused by the merger doctrine. Defendants object to the news report being used for certain purposes. Judicial notice will not be taken because the news report is unnecessary for decision on the merger issue.

Appendix B

I.

Background

Richard Satava is a glass artist who has owned and operated his studio, Satava Art Glass, in Chico, California, since 1977. Decl. of Richard Satava ("Satava Decl.") at 1. In the late 1980's Satava was inspired by the jellyfish display at the Monterey Bay Aquarium ("MBA") to create glass-in-glass jellyfish sculptures and began that work at least as early as 1990.[3] *Id.* at 2. Satava's representation of a jellyfish is: "a vertically oriented, colorful, fanciful jellyfish with tendril-like tentacles and a rounded [bell] encased in an outer layer of rounded clear glass that is bulbous at the top and tapering toward the bottom to form roughly a bullet-shape, with the jellyfish portion of the sculpture filling almost the entire volume of the outer, clear glass" shroud. Pls.' Reply at 3. In 1990, Satava began exhibiting and selling the sculptures at the MBA. Satava Decl. at 1.

Glass-in-glass art is a centuries-old art form which consists of a glass sculpture inside of a second glass sculpture, commonly called the shroud. Barnard Decl., Ex. H1-02. After

3. Jellyfish exist in a wide variety of forms, sizes, shapes, and colors. Decl. of Delbert J. Barnard ("Barnard Decl."), Ex. H1-03. Some are as small as a marble, while others are over 100 feet in length. *Id.* The body of the jellyfish is called the bell, which is surrounded along the edge by various length tentacles, or string-like structures. *Id.* Some jellyfish have ruffled tentacle-like "mouth-arms" which descend from the mouth on the center of the bottom of the bell. *Id.* Jellyfish sometimes act as hosts, carrying small ocean animals and plants through the water. *Id.* Jellyfish float in ocean currents, often in an angular direction, but sometimes straight up or down. *Id.*

the first glass sculpture is created, the artist puts it into molten glass to pick up additional glass gatherings that create the shroud which encapsulates the first sculpture, thus creating a glass-in-glass sculpture. Decl. of W. Christopher Lowry ("Lowry Decl.") at 2. The additional gatherings are malleable and can be manipulated into any shape the artist desires. Supp. Decl. of Richard Satava ("Supp. Satava Decl.") at 3; *see also* Dep. of Christopher Lowry ("Lowry Dep.") at 144 (stating that there are a myriad of ways that one could portray jellyfish in glass art): Dep. of William "Bill" Worcester ("Bill Dep.") at 53 ("We tried spherical ones, we tried flat ones, we tried all kinds of shapes."); Dep. of Christopher Richards ("Richards Dep.") at 90 (explaining that a triangle shape is possible to create). The shape of the additional gatherings of glass is not dictated by the shape of the sculpture inside. Supp. Satava Decl. at 3.

Satava designs and creates approximately 300 jellyfish sculptures each month. *Id.* Satava's jellyfish sculptures are among his best-selling works and are exhibited and sold at galleries, gift shops, and other retail establishments in over forty states. *Id.* Since 1995, Hawaii has been the largest and most consistent market for Satava's jellyfish sculptures. *Id.* Satava sells his jellyfish in seven locations on Maui, five locations on Oahu, two locations on the "big island" of Hawaii, and two locations on Kauai. *Id.* at 2-3. These galleries prominently display Satava's works, often in the street-front window so as to attract the attention of passers-by. Decl. of Al Roberge ("Roberge Decl.") at 2; Decl. of Sunny Jordan ("Jordan Decl.") at 2; Decl. of Laurie Baron ("Baron Decl.") at 1; Decl. of Connie Sutherland ("Sutherland Decl.") at 1-2.

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Photographs of Satava's jellyfish sculptures have appeared in Hawaiian tourist brochures, which are distributed throughout the islands. Satava Decl. at 4. Advertisements for Satava's jellyfish sculptures appear in national arts and crafts magazines, including *American Craft* and *American Style*. *Id.* In 1996, Lowry saw a picture of one of Satava's jellyfish sculptures in an issue of *American Craft*. Lowry's Answers to Satava's First Set of Interrogs ("Lowry's Interrogs") at 11.

Sally and Bill Worcester opened Hot Island Glass in 1992 and operated it until they retired in 2000. Dep. of Sally Worcester ("Sally Dep.") at 7. Lowry began working as a glass blower at Hot Island Glass in 1992. Lowry's Interrogs at 3. Richards, the Worcester's nephew, worked as a glass blower at Hot Island Glass from 1991 to 1993 and returned in 1997. In May 2000, Lowry and Richards formed a partnership and purchased Hot Island Glass from the Worcesters. *Id.* at 9.

Sally was inspired to create glass jellyfish art after visiting the jellyfish exhibit at the MBA in the late 1980's or early 1990's. Sally Dep. at 9, 43. During this visit she went into the gift shop and gallery, but does not recall seeing any of Satava's work. *Id.* at 44-45. Sally created one of her earliest versions of a jellyfish sculpture in 1992. *Id.* at 9. Sally's jellyfish art took the following forms: a round glass ball shroud with a globular inner sculpture without any tentacles or an egg-shaped shroud with a globular inner sculpture with descending swirly strands. Barnard Decl., Ex. H1-11. Her jellyfish are abstract in nature, and appear less life-like than Satava's. *Id.*; *see also* Sally Dep. at 23-24.

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In 1993, Lowry made one of his earliest jellyfish sculptures, which was a round ball-shaped shroud with a globular inner sculpture. Barnard Decl., Ex. H1-11. Others told Lowry it looked like a jellyfish, though it had no tentacles. Opp'n at 1.

The jellyfish sculptures at Hot Island Glass in the early 1990's were different from those at issue in this case. *See* Bill Dep. at 59 (stating that Lowry and Richards "probably started [creating jellyfish sculptures] earlier than [1998], and they probably evolved. You know, it was probably some kind of a slow evolvement ***until we got to the 1998 one, and then they started selling, and then they continued to get made and the shapes changed***."); Richards Dep. at 19-20 (describing pre-1998 jellyfish sculptures as small and in the shape of eggs or jelly beans); Dep. of Karen McCarthy at 22, 28 (stating that at some point between 1994 and 1996, she saw a Hot Island Glass jellyfish sculpture that was a small paperweight with a globular sculpture inside, which looked to her like a jellyfish without tentacles. She stated Hot Island Glass "certainly made jellyfish that are different looking than some of the jellyfish I see today.") Hot Island Glass did not begin selling jellyfish sculptures of the type at issue in this case until the late 1990's. *See* Sutherland Decl. at 2 (stating she first saw Hot Island Glass's jellyfish sculptures approximately two years ago); Roberge Decl. at 2 (sometime after May 2000); Decl. of Rene Wineland at 2 (late 1999 or early 2000; either Bill or Lowry told her the sculptures were among the studio's newest work); Jordan Decl. at 3 (November 1999); Decl. of Laurie Baron (August 9, 2000); Decl. of Rick Strini at 2 (1999). The earliest Hot Island Glass jellyfish sculpture owned by anyone known to Lowry was created in 1998. Lowry Dep. at 22.

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In 1997, a customer brought a Satava jellyfish sculpture to Hot Island Glass for repair work. Lowry's Interrogs at 11. The jellyfish had a silver-blue top and black tentacles. *Id.* Hot Island Glass had the piece for approximately two days. *Id.* Bill first became aware of Satava's jellyfish sculptures in the mid-1990's. Bill Dep. at 19. Bill stated he "took a pretty good look at [Satava's jellyfish sculptures]" when he saw them. *Id.* at 20. Sally declares she saw Satava jellyfish sculptures for the first time on the mainland. Sally Dep. at 47.

Members of the public have confused Hot Island Glass's jellyfish sculptures with Satava's. *See* Decl. of Patrick Reilley at 1-2 (explaining that when he was in Hawaii during the summer of 2000, he purchased what he thought was a Satava jellyfish sculpture for his father, who collects Satava's works. He later learned the sculpture was made by Hot Island Glass, not Satava.); Dep. of Fred LaCount at 26-27 (stating customers have asked him if the works displayed at his gallery (Hot Island Glass's) are the same as those displayed at the Whaler (Satava's)). Some people have pointed out the similarities between Hot Island Glass's jellyfish sculptures and Satava's to Defendants. Roberge Decl. at 2 (explaining that a representative from Hot Island Glass approached him and offered to sell what appeared to be copies of Satava's jellyfish sculptures. Roberge informed the representative that the work appeared to be copies of Satava's, and the representative from Hot Island Glass did not protest Roberge's observation); Baron Decl. at 2-3 (recounting a conversation she had with Lowry wherein she informed him that she could not exhibit Hot Island Glass's jellyfish because they appeared to be reproductions of Satava's. Lowry told

her that he and Richards "had recently purchased Hot Island Glass and the financial burden of the new studio was such that they felt they had to produce artwork that [was] proven to sell quickly and produce consistent profits."). Christopher Richards has had conversations with people about the similarity of the Hot Island Glass jellyfish sculptures and those in other galleries. Richards Dep. at 53, 66.

Other artists have created a wide variety of glass art depicting jellyfish, including windchimes, lamps, paperweights, sculptures, and bowls, representing jellyfish in a wide range of colors, positions, and shapes. Supp. Decl. of Monica C. Hayde ("Supp. Hayde Decl."), Ex. D. Some artists incorporate other sea life, including plants and other animals, in their jellyfish art. *Id.*

II.

Analysis

A. Whether Glass-in-Glass Jellyfish Sculptures are Entitled to Copyright Protection

Defendants present several arguments, which if accepted, would preclude Satava's glass-in-glass jellyfish sculptures from having copyright protection. Satava denies that any of these theories apply to the work at issue.

1. Merger of Idea and Expression

First, Defendants assert that the idea of a "glass-in-glass art medium for encapsulating a . . . jellyfish sculpture in a body of . . . glass" (hereinafter "glass-in-glass jellyfish

sculpture") is inseparable from the expression thereof.[4] Opp'n at 12. Copyright "protection is given only to the expression of the idea — not [to] the idea itself." *Mazer v. Stein*, 347 U.S. 201, 217 (1954). "A copyright bars . . . use of the particular 'expression' of an idea in a copyrighted work but does not bar use of the 'idea' itself." *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 741 (9th Cir. 1971). "When the 'idea' and its 'expression' are . . . inseparable, copying the 'expression' will not be barred, since protecting the 'expression' in such circumstances would confer a monopoly of the 'idea' upon the copyright owner free of the conditions and limitations imposed by the patent law." *Id.* at 742. "[C]ourts will not protect a copyrighted work from infringement if the idea underlying the copyrighted work can be expressed in only one way, lest there be a monopoly on the underlying idea." *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1082 (9th Cir. 2000).

Satava presented evidence which refutes Defendants' contention that the idea and the expression are inseparable. Satava presented an example of a glass-in-glass jellyfish sculpture which does not resemble those created by Satava or Hot Island Glass. Supp. Hayde Decl., Ex. D (Steven Lundberg art). Additionally, Defendants have presented evidence of their own creations, such as the Single, Double, and Triple Window jellyfish sculptures, which are distinct from the glass-in-glass jellyfish sculptures at issue in this case. Barnard Decl., Ex. H1-11. Thus, it cannot be said that the idea and the expression are merged.

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4. Defendants state the idea as "the glass-in-glass art medium for encapsulating a ***realistic*** jellyfish sculpture in a body of ***clear*** glass." Opp'n at 12. However, "realistic" and "clear" are descriptive of the *expression* of the idea, not descriptive of the idea itself.

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2. Public Domain

Defendants also contend that an artistic depiction of a jellyfish is not entitled to protection because it is merely an object in the public domain. Opp'n at 12-13. However, "[t]he mere fact that [Satava] used a matter in the public domain does not in and of itself preclude a finding of originality, since [Satava] . . . added unique features to the matter [such as the bullet-shaped glass shroud] so as to render it copyrightable." *See Kamar Int'l, Inc. v. Russ Berrie & Co.*, 657 F.2d 1059, 1061 (9th Cir. 1981) (finding stuffed animals to be copyrightable) (quoting *R. Dakin & Co. v. A & L Novelty Co.*, 444 F. Supp. 1080, 1083-84 (E.D.N.Y. 1978).

3. Physiognomy

Defendants also contend that any similarity is merely the result of the physiognomy of jellyfish. Defendants make two arguments under this concept. First, Defendants contend that the clear bullet-shaped glass shroud is "the most common and easiest to make," given the natural shape of the jellyfish sculpture inside. Opp'n at 15. However, evidence proffered by Satava and Defendants contradicts this. Supp. Satava Decl. at 3; Lowry Dep. at 144; Bill Dep. at 53; Richards Dep. at 90.

Second, Defendants assert that the position of the jellyfish in the sculptures, that of an upward swimming jellyfish, is "a position that a jellyfish commonly assumes in nature." Opp'n at 16. However, evidence presented by Defendants refutes this. Defendants presented photocopies from *A Guide to the World of Jellyfish*, which shows jellyfish

positioned in many different angles. Barnard Decl., Ex. H1-03. Of the approximately thirty-two pictures clearly depicting a floating jellyfish, only five show the jellyfish floating in a straight upright vertical position, and none of those five are the *pelagia colorata*, which Defendants assert inspired their creation. *Id.* Some are floating downward, and most are floating at an angle, including the pictures of *pelagia coloratas*.[5] *Id.* Thus, the position of the jellyfish in a vertical floating position is not unprotectable physiognomy of jellyfish.

4. *Scenes a Faire*

Finally, Defendants contend that any similarity between Satava's jellyfish sculptures and those created by Hot Island Glass is the result of *scenes a faire*, or the concept that certain patterns, depictions, or scenes are bound to recur in artistic work dealing with a particular theme or topic. Under this doctrine, "courts will not protect a copyrighted work from infringement if the expression embodied in the work necessarily flows from a commonplace idea." *Ets-Hokin*, 225 F.3d at 1082. Evidence propounded by Satava refutes this argument. Satava presented evidence of seven other artistic depictions of glass jellyfish sculptures, none of which resemble those at issue in this case. Additionally, Defendants presented evidence of their own work which refutes this,

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5. The pictures of the *pelagia colorata* in Defendants' exhibit reflect a very different animal than those created by Defendants. Those in the book have "fewer outer tentacles, a thick, ruffled "mouth-arm," and, in at least one [picture], a [bell] comprised of separate "petals" of tissue rather than a continuous surface." Reply at 6 (*citing* Barnard Decl., Ex. H1-03).

including the Single, Double, and Triple Window jellyfish sculptures and the sculptures with multiple jellyfish inside one shroud. As there are potentially limitless ways of depicting jellyfish in glass sculptures, given the vast variety of jellyfish and ocean life, *scenes a faire* is not applicable.

Since Defendants have not established that Satava's work falls outside the scope of copyright protection, the next step requires application of the Ninth Circuit's analysis for determining whether infringement has occurred.

B. Infringement Analysis

To prevail on a motion for a preliminary injunction under the Copyright Act, Satava must demonstrate "either (1) a combination of probable success on the merits and the possibility of irreparable injury, or (2) that serious questions are raised and the balance of hardships tips sharply" in favor of the moving party. *Big Country Foods, Inc. v. Bd. of Educ. of Anchorage Sch. Dist.*, 868 F.2d 1085, 1088 (9th Cir. 1989). "These two alternatives are not separate tests but the outer reaches of a single continuum." *Smart Inventions, Inc. v. Allied Communications Corp.*, 94 F. Supp. 2d 1060 (C.D.Cal. 2000). "In a copyright infringement action . . . [a] showing of a reasonable likelihood of success of the merits raises a presumption of irreparable harm." *Triad Sys. Corp. v. Southeastern Express Co.*, 64 F.3d 1330, 1335 (9th Cir. 1995).

To demonstrate a likelihood of success on the merits, Satava must (1) prove ownership of a valid copyright and (2) set forth evidence sufficient to establish that Defendants had access to his artwork and copied his protectable

expression. *See Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1162 (9th Cir. 1977) (hereinafter "*Krofft*").

Defendants assert "the particular expression that is subject to Satava's copyright registration is shown by Exhibit H1-8" to the Declaration of Delbert Barnard. Opp'n at 3. Satava counters that works derivative from those in Exhibit H1-8 are also protected. A derivative work is "a work based upon one or more preexisting works," 17 U.S.C. § 101, and a copyright owner has the exclusive right to "prepare derivative works based upon the copyrighted work." 17 U.S.C. § 106(2). "[A] work will be considered a derivative work only if it would be considered an infringing work if the material which it has derived from a preexisting work had been taken without the consent of a copyright proprietor of such preexisting work." *Mirage Editions, Inc. v. Albuquerque A.R.T. Co.*, 856 F.2d 1341, 1343 (9th Cir. 1988) (*quoting* 1 Nimmer on Copyright § 3.01 (1986)). "[A]n infringement is not confined to literal and exact repetition or reproduction; it includes also the various modes in which the matter of any work may be adopted, imitated, transferred, or reproduced, with more or less colorable alterations to disguise the piracy." *Krofft*, 562 F.2d at 1167 (quoting *Universal Pictures Co v. Harold Lloyd Corp.*, 162 F.2d 354, 360 (9th Cir. 1947). Thus, derivative works of Satava's work shown in Exhibit H1-8 are also protected.

1. Access

To prove "access." Satava must establish Defendants had "a 'reasonable opportunity' or 'reasonable possibility' of viewing the plaintiff[s'] work." *Three Boys Music Corp.*

v. Bolton, 212 F.3d 477, 482 (9th Cir. 2000) (internal quotation marks omitted). Satava presented both direct and circumstantial evidence to establish that Defendants "had an opportunity to view or to copy [his] work." *Krofft*, 562 F.2d at 1172. Lowry has admitted that he viewed Satava's jellyfish sculptures in a magazine in 1996 and when one of Satava's jellyfish sculptures was brought to Hot Island Glass for repair in 1997. Bill admitted he saw Satava's work as early as the mid-1990's. "[D]efendants' admission that they had access to [Satava's work] is a factor to be considered in favor of [Satava]." *See Shaw v. Lindheim*, 919 F.2d 1353, 1362 (9th Cir. 1990).

Satava's jellyfish sculptures have been broadly exhibited throughout Hawaii since 1995 and photographs of the sculptures have appeared in Hawaiian tourist brochures. Actionable copying can be inferred from Defendants' access to the public display of Satava's jellyfish sculptures. *Eve of Milady v. Impression Bridal, Inc.*, 957 F. Supp. 484, 489 (S.D.N.Y. 1997). Satava has presented sufficient evidence to establish that Defendants had such access to his copyrighted work. "[W]here clear and convincing evidence of access exists, as here, the degree of proof necessary to show substantial similarity may be lower." *Spectravest, Inc. v. Mervyn's Inc.*, 673 F. Supp. 1486, 1491 (N.D.Cal. 1987) (*citing Krofft*, 562 F.2d at 1172).

2. Substantial Similarity

The Ninth Circuit employs a two part test to determine if Defendants' work product is "substantially similar" to Satava's copyrighted product. The first part of this test,

known as the extrinsic or objective prong, focuses on "whether there are substantial similarities in *both* ideas and expression." *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1442 (9th Cir. 1994). The second part of the test, known as the intrinsic prong, "evaluates the similarity of expression from the standpoint of [an] ordinary reasonable observer and measures expression subjectively, looking for substantial similarity in the 'total concept and feel of the works.'" *Smart Inventions*, 94 F. Supp. 2d at 1065 (*quoting Data East USA, Inc. v. Epyx, Inc.*, 862 F.2d 204, 208 (9th Cir. 1998).

a. Extrinsic Test

The extrinsic test "depends . . . on specific criteria which can be listed and analyzed. Such criteria include the type of artwork involved, the materials used, the subject matter, and the setting for the subject." *Krofft*, 562 F.2d at 1164. In the instant case, both works are decorative glass-in-glass sculptures designed to be displayed on a shelf or desktop, both are made from hand-blown glass, both are the same sizes and shapes, and both incorporate virtually identical depictions of jellyfish. This is sufficient to satisfy the extrinsic test. *See e.g. Carol Cable Co. v. Grand Auto, Inc.*, No. C-87-1036 MHP, 1987 WL 14544, at *7 (N.D.Cal 1987) (extrinsic test satisfied where "two works involve the same general ideas [and] both involve precisely the same type of artwork and design"); *Nat'l Theme Prods. Inc. v. Jerry B. Beck, Inc.*, 696 F. Supp. 1348, 1355 (S.D.Cal. 1988) (substantial similarity in animal costumes found where "[t]he subject matter, materials and type of artwork [were] virtually identical").

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"The extrinsic test is an objective comparison of specific expressive elements." *Cavalier v. Random House, Inc.*, 2002 WL 1042182, at *4 (9th Cir., May 21, 2002). "[T]he unprotectable elements have to be identified, or filtered, before the works can be considered as a whole." *Apple Computer*, 35 F.3d at 1446. "Because only those elements of a work that are protectable . . . can be compared when it comes to the ultimate question of illicit copying, [the court] use[s] analytic dissection to determine the scope of copyright protection before works are considered 'as a whole.'" *Id.* at 1443. A three step analysis effectuates this goal.

First, Satava "must identify the source(s) of the alleged similarity between his work and the defendant[s'] work." *Id.* Satava alleges the sculptures created by him and Defendants are of "a vertically oriented, colorful, fanciful jellyfish with tendril-like tentacles and a rounded [bell] encased in an outer layer of rounded clear glass that is bulbous at the top and tapering toward the bottom to form roughly a bullet-shape, with the jellyfish portion of the sculpture filling almost the entire volume of the outer, clear glass" shroud. Reply at 3.

Second, "the court must determine whether any of the allegedly similar features are protected by copyright." *Apple Computer*, 35 F.3d at 1443. The orientation, proportion, and depiction of the jellyfish is protectable, as is the shape, size, and color of the shroud.

Third, "[h]aving dissected the alleged similarities and considered the range of possible expression, the court must define the scope of the plaintiff[s'] copyright — that is, decide

whether the work is entitled to 'broad' or 'thin' protection." *Id.* Thin protection applies to a copyrighted work which consists "of unprotectable elements, or elements limited by merger, scenes a faire, and/or other limiting doctrines." *Idema v. Dreamworks, Inc.*, 162 F. Supp. 2d 1129, 1178 (C.D.Cal. 2001) (internal quotation marks omitted). Since Satava's works are not so limited, they are entitled to "broad protection."

Therefore, Satava has satisfied the extrinsic prong of the test.

b. Intrinsic Test

The second prong of the substantial similarity test "depend[s] on the response of the ordinary reasonable person." *Krofft*, 562 F.2d at 1163. "The two works . . . should be considered and tested, not hypercritically or with meticulous scrutiny, but by the observations and impressions of the average reasonable . . . spectator." *Twentieth Century-Fox Film Corp. v. Stonesifer*, 140 F.2d 579, 582 (9th Cir. 1944).

The testimonial evidence supports the conclusion that ordinary reasonable persons find Defendants' and Satava's works to be substantially similar. *See* Decl. of Patrick Reilley at 1-2; Dep. of Fred LaCount at 26-27; Roberge Decl. at 2; Baron Decl. at 2-3. Additionally, this Court finds the sculptures to be substantially similar. Therefore, Satava has satisfied the second prong, the intrinsic test.

Appendix B

Since Satava has shown a likelihood of success on the merits of his copyright infringement claim, Satava has raised a presumption of irreparable harm. *Triad*, 64 F.3d at 1335. Therefore, Satava is entitled to a preliminary injunction.

III.

Conclusion

Defendants are enjoined from making and selling copies of Satava's jellyfish sculptures, specifically sculptures with

> a vertically oriented, colorful, fanciful jellyfish with tendril-like tentacles and a rounded [bell] encased in an outer layer of rounded clear glass that is bulbous at the top and tapering toward the bottom to form roughly a bullet-shape, with the jellyfish portion of the sculpture filling almost the entire volume of the outer, clear glass shroud

up to and through a trial on the merits of this case. A preliminary injunction shall not issue under Rule 65 unless plaintiffs give security in a sum deemed appropriate. *See* Fed. R. Civ. P. 56. The district court has discretion to determine the amount. *Nintendo, Inc. v. Lewis Galoob Toys, Inc.*, 16 F.3d 1032, 1036-37 (9th Cir. 1994).

This preliminary injunction shall become effective upon Plaintiffs posting bond in the amount of $10,000.[6]

---

6. Defendants' request for costs and attorneys fees is denied. *See* Opp'n at 21.

Appendix B

IT IS SO ORDERED.

Dated: June 11, 2002

s/ Garland E. Burrell, Jr.
GARLAND E. BURRELL, JR.
UNITED STATES DISTRICT JUDGE

APPENDIX C — ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT DENYING PETITION FOR REHEARING AND REHEARING EN BANC FILED MAY 27, 2003

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

No. 02-16347

D.C. No. CV-01-00701-GEB
Eastern District of California, Sacramento

RICHARD SATAVA, an individual;
SATAVA ART GLASS, a sole proprietorship,

Plaintiffs - Appellees,

v.

CHRISTOPHER LOWRY, an individual; CHRISTOPHER RICHARDS, an individual; MAKAWAO GLASSWORKS, LLC, dba Hot Island Glass,

Defendants - Appellants.

ORDER

Before: SILVERMAN and GOULD, Circuit Judges, and WEINER,* Senior Judge.

---

* The Honorable Charles R. Weiner, Senior United States District Judge for the Eastern District of Pennsylvania, sitting by designation.

Appendix C

The Petition for Rehearing is DENIED.

The full court has been advised of the Petition for Rehearing En Banc, and no judge of the court has requested a vote on the Petition for Rehearing En Banc. Fed. R. App. P. 35. Appellant's Petition for Rehearing En Banc is DENIED.

Appellees have requested leave to file a "Reply in Support of Petition for Rehearing and Suggestion for Rehearing En Banc." The request is DENIED.

APPENDIX D — RULES INVOLVED

UNITED STATES CODE ANNOTATED
TITLE 17. COPYRIGHTS
CHAPTER 1—SUBJECT MATTER AND SCOPE OF COPYRIGHT

17 U.S.C.A. § 102

§ 102. Subject matter of copyright: In general

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

(1) literary works;

(2) musical works, including any accompanying words;

(3) dramatic works, including any accompanying music;

(4) pantomimes and choreographic works;

(5) pictorial, graphic, and sculptural works;

(6) motion pictures and other audio-visual works;

(7) sound recordings; and

(8) architectural works.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

Appendix D

UNITED STATES CODE ANNOTATED
TITLE 17. COPYRIGHTS
CHAPTER 4—COPYRIGHT NOTICE, DEPOSIT, AND REGISTRATION

§ 410. Registration of claim and issuance of certificate

(a) When, after examination, the Register of Copyrights determines that, in accordance with the provisions of this title, the material deposited constitutes copyrightable subject matter and that the other legal and formal requirements of this title have been met, the Register shall register the claim and issue to the applicant a certificate of registration under the seal of the Copyright Office. The certificate shall contain the information given in the application, together with the number and effective date of the registration.

(b) In any case in which the Register of Copyrights determines that, in accordance with the provisions of this title, the material deposited does not constitute copyrightable subject matter or that the claim is invalid for any other reason, the Register shall refuse registration and shall notify the applicant in writing of the reasons for such refusal.

(c) In any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the

copyright and of the facts stated in the certificate. The evidentiary weight to be accorded the certificate of a registration made thereafter shall be within the discretion of the court.

(d) The effective date of a copyright registration is the day on which an application, deposit, and fee, which are later determined by the Register of Copyrights or by a court of competent jurisdiction to be acceptable for registration, have all been received in the Copyright Office.

No. 03-314

Supreme Court, U.S.
FILED
SEP 29 2003
OFFICE OF THE CLERK

In The

Supreme Court of the United States

RICHARD SATAVA, an individual;
SATAVA ART GLASS, a sole proprietorship,

Petitioners,

v.

CHRISTOPHER LOWRY, an individual;
CHRISTOPHER RICHARDS, an individual;
MAKAWAO GLASSWORKS, LLC, dba
HOT ISLAND GLASS,

Respondents.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Ninth Circuit

BRIEF IN OPPOSITION

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INTRODUCTION

Defendants/Respondents Christopher Lowry, an individual, Christopher Richards, an individual and Makawao Glassworks LLC, d/b/a Hot Island Glass, submit this Opposition Brief in response to the Petition for a Writ of Certiorari filed by Plaintiff/Petitioner Richard Satava, an individual, d/b/a Satava Art Glass.

REASONS FOR DENYING THE PETITION

Overview

Petitioner asserts two reasons why this Court should review the decision by the Ninth Circuit. Firstly, he contends that the Ninth Circuit's decision conflicts with the holdings of this Court and several circuit courts. Secondly, he argues that the concept of a "thin" copyright, set forth in *Feist Pubs Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991), and several circuit cases, should not be applied to "art". Petitioner is incorrect when he asserts that the Ninth Circuit's decision conflicts with cases from the Ninth and other circuits. The concept of "thin" copyright protection is a part of a law of the Ninth Circuit and the other Circuits referred to by Petitioner. The Ninth Circuit did not reshape substantive law when it reversed the district court's grant of a Preliminary Injunction. Rather, it applied the law of this Court and the Ninth and other Circuits to the record facts. It was Petitioner who was asking the Ninth Circuit to reshape substantive law by extending copyright protection to elements that are not original to Petitioner. *Feist Pubs v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991) applies in this case. *Feist* is not limited to telephone directories, but applies to discoverable

facts in any type of work. There was no improper fact finding by the Ninth Circuit. The Ninth Circuit did not misread and/or rewrite facts in a way that conflicts with the record. In the Ninth Circuit decision, the Ninth Circuit referred to substantial and significant parts of the record that support its conclusions.

Factual Background

Petitioner and Respondents both make and sell glass-in-glass jellyfish sculptures which are inspired by real life jellyfish. The real life jellyfish in question are basically characterized by a bell at its top and tentacles depending from the bell. At times this jellyfish swims upwardly in a vertical orientation. The glass-in-glass art medium is well established and involves a basic process. A glass art object is formed on the end of a rod or "pontil". Then, the end of the "pontil" and the glass art object are dipped into molten glass to pick up more glass to form a glass shroud around the glass object. The shroud shape in question (a "gather" shape) is not original with Petitioner but rather is a common shape that results when the glass art object inside the shroud is taller than it is wide and is wider at its top than at its bottom. This "gather" shaped shroud is an economical shape because it requires less time, skill and materials than do other shroud shapes.

Petitioner and Respondents' jellyfish sculptures both show a jellyfish in a vertical orientation, with its bell at the top and its tentacles depending from the bell. Both are encased in a clear glass shroud so that observers can look into the shroud and see the jellyfish. There are substantial

differences, however, between Petitioner and Respondents' jellyfish involving shape, color and arrangement of the bell and tentacles of the jellyfish.

The Ninth Circuit Acknowledged That Satava's Jellyfish Sculptures Are Copyrightable

In its decision, the Ninth Circuit stated:

> **We do not mean to suggest that Satava has added nothing copyrightable to his jellyfish sculptures. He had made some copyrightable contributions: the distinctive curls of particular tendrils; the arrangement of certain hues; the unique shape of jellyfishes' bells. To the extent that these and other artistic choices were not governed by jellyfish physiology or the glass-in-glass medium, they are original elements that Satava may theoretically protect through copyright law. Satava's copyright on these original elements (or their combination) is "thin", however, comprising no more than the original contribution to ideas already in the public domain. Stated in another way, Satava may prevent others from copying the original features he contributed, but he may not prevent others from copying elements of expression that nature displays for all observers, or that the glass-in-glass medium suggests to all sculpturers.**

Satava v. Lowry, 323 F.3d at 812.

The Ninth Circuit Decision Does Not Conflict With *Bleistein*

Bleistein v. Donaldson Lithographing Co., 188 U.S. 239 (1903) involved pictorial illustrations that were part of circus advertisements. The lower courts had ruled that the pictorial illustrations were not covered by the copyright laws. The Sixth Circuit stated:

> **What we hold is this: that if a chromo, lithograph, or other print, engraving, or picture has no other use than that of a mere advertisement, and no value aside from this function, it would not be promotive of the useful arts, within the meaning of the constitutional provision, to protect the 'author' in the exclusive use thereof, and the copyright statute should not be construed as including such a publication, if any other construction is admissible.**

Later in its decision the Sixth Circuit further stated with respect to the pictorial illustration that:

> **It must have some connection with the fine arts to give it intrinsic value – The jury could not reasonably have found merit or value aside from the purely business object of advertising a show, and the instruction to find for the defendant was not error.**

On review, this Court rejected this view and stated:

> **A picture is none the less a picture, and none the less a subject of copyright, that it is used for an advertisement.**

The issue in this case is not the issue that was before the court in *Bleistein*. In its decision, the Ninth Circuit stated:

> **Satava may prevent others from copying the original features he contributed, but he may not prevent others from copying elements of expression that nature displays for all observers, or that the glass-in-glass medium suggests to all sculptures.**

Satava v. Lowry, 323 F.3d at 812. Quite clearly, the Ninth Circuit decision does not conflict with this Court's holding in *Bleistein*.

The Ninth Circuit Decision Is Consistent With Ninth Circuit Precedent

The Ninth Circuit cited several Ninth Circuit cases in support of its holding, including *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068 (9th Cir. 2000) ("When we apply the limiting doctrines, subtracting the unoriginal elements, Ets-Hokin is left with . . . a 'thin' copyright, which protects against almost virtually identical copying."); and *Apple Computer, Inc. v. Microsoft Corporation*, 35 F.3d 1435, 1439 (9th Cir. 1994) ("When the range of protectable expression is narrow, the appropriate standard for illicit copying is virtual identity").

The Ninth Circuit stated:

> **We do not hold that realistic depictions of live animals cannot be protected by copyright. In fact, we have held to the contrary. See *Kamar Int'l, Inc. v. Russ Berrie & Co.*, 657 F.2d 1059, 1061 [216 USPQ 376] (9th Cir. 1991). We recognize, however, that the scope**

> **of copyright protection in such works is narrow. See *Herbert Rosenthal Jewelry, Corp. v. Kalpakian*, 446 F.2d 738, 741 [170 USPQ 557](9th Cir. 1971) ("Any inference of copying based upon similar appearance lost much of its strength because both [works] were lifelike representations of a natural creature"). Nature gives us ideas of animals in their natural surroundings: an eagle with talons extended to snare a mouse; a grizzly bear clutching a salmon between its teeth; a butterfly emerging from its cocoon; a wolf howling at the full moon; a jellyfish swimming through tropical waters. These ideas, first expressed by nature, are the common heritage of humankind, and no artist may use copyright law to prevent others from depicting them.**

Satava, 323 F.3d at 812.

The Ninth Circuit based its decision on *Ets-Hokin, Kamar* and *Herbert Rosenthal* (1971); *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1109-10 (9th Cir. 1970); *See v. Durang*, 711 F.2d 141, 143 (9th Cir. 1983); and *Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 901 (9th Cir. 1987) ("No copyright protection may be afforded to the idea of producing stuffed dinosaur toys or to elements of expression that necessarily follow from the idea of such dolls." "Appellants therefore may place no reliance upon any similarity in expression resulting from either the physiognomy of dinosaurs or from the nature of stuffed animals.")

The Ninth Circuit further stated:

> **An artist may, however, protect the original expression he or she contributes to these ideas. An artist may vary the pose, attitude,**

> **gesture, muscle structure, facial expression, coat or texture of animal. An artist may vary the background, lighting or perspective. Such variations, *if original*, may earn copyright protection. Because Satava's jellyfish sculptures contain few variations of this type, the scope of his copyright is narrow.** (emphasis added)

Satava, 323 F.3d at 813.

In *Kamar*, the Ninth Circuit made reference to an earlier case in which a district court had stated:

> **"[T]he mere fact that plaintiff used a matter in the public domain does not in and of itself preclude a finding of originality, since plaintiff may have added unique features to the matter so as to render it copyrightable." *Kamar*, 657 F.2d at 1061.**

The *Kamar* court later stated:

> **That which was original, and copyrightable, was the special texture and design of the stuffed animals.**

Id., 657 F.2d at 1062.

A similar finding was made by the Ninth Circuit in its decision:

> **[Satava] made some copyrightable contributions: the distinctive curls of particular tendrils; the arrangement of certain hues; the unique shape of jellyfishes' bells.**

Satava, 323 F.3d at 312.

The Ninth Circuit decision is also consistent with *Ets-Hokin v. Skyy Spirits, Inc.*, 323 F.3d 766 (9th Cir. 2003)

("[T]he range of protectable expression is constrained by both the subject matter idea of the photograph and the conventions of the commercial product shot.") Here, the "subject matter idea" involves jellyfish in a natural position and the "conventions" involve common features of the glass-in-glass art medium.

The Ninth Circuit Decision Does Not Conflict With Decisions From Other Circuits

Petitioner cites four cases from other Circuits: *Knitwaves v. Lollytogs Ltd.*, 71 F.3d 996 (2nd Cir. 1995); *Concrete Machinery Co. v. Classic Lawn Ornaments*, 843 F.2d 600 (1st Cir. 1988); *Rushton v. Vitale*, 218 F.2d 434 (2nd Cir. 1955); and *Masquerade Novelty v. Unique Industries, Inc.*, 912 F.2d 663 (3rd Cir. 1990). These cases do not support Petitioner's arguments.

Knitwaves involves designs on children's sweaters. One of the sweaters included a squirrel and leaves on a multi-panel front. In its decision, the Second Circuit Court stated that what is protectable is "the author's original contributions". It made reference to *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 19 USPQ2d 1418 (2nd Cir. 1991) in which the Court had narrowed the scope of copyright because an ornate background was in the public domain and thus was not a part of the original contribution by the copyright owner.

The First Circuit Court stated in *Concrete Machinery* that an artist can claim to own only an original manner of expressing ideas, not the ideas themselves. A copyright owner cannot succeed with an infringement action simply because the accused infringer also produced concrete statutes of deer, swans or donkeys. The copyright owner

must demonstrate that the accused infringer's works are substantially similar to the copyright owner's "original expression". In support of its decision, the court cited *Mazer v. Stein*, 347 U.S. 201 (1954) and *Herbert Rosenthal* (1971). Then the *Concrete Machinery* court stated:

> **As an example in this case before us, appellant has a copyright in a design of concrete "life-sized deer". The idea behind this particular expression can be briefly described as a "realistic-looking deer". Appellant cannot prohibit others from appropriating this idea; it can, however, prohibit any actual copying of its own version of a "realistic-looking concrete deer". Yet, it has a problem of proof: because the statue is a detailed replica of a real deer, the deer, *in essence, supplied most of the features which any subsequent artist can also take from the real deer.*** (emphasis added)

Id., 843 F.2d at 607. Here, the general jellyfish features (bell, tentacles, swimming upwardly) are supplied by the jellyfish.

The *Concrete Machinery* court further stated that on rehearing "the [district] court should 'dissect' the works to identify those aspects which Concrete likely will be able to show are protected expression and were copied by Classics." *Id.*, 843 F.2d at 611.

Rushton involved a doll in the form of a chimpanzee. The Second Circuit Court made reference to *Mazer* and stated that an author is entitled to copyright protection if he contributed something that was recognizably his own. The Court stated that "[o]riginality in this context means little more than a prohibition of actual copying." 218 F.2d

at 435. Without describing it, the Court concluded that the chimpanzee included a contribution by the author that the defendant had copied.

Masquerade involved copyrighted nose masks. The defendant contended that the masks were not entitled to copyright protection because they were "useful articles" under § 101. The Third Circuit Court rejected this argument and remanded the case for further proceedings on the issue of infringement. It further stated, "[w]e acknowledge that Masquerade may have difficulty in demonstrating infringement on remand, given that their nose masks and the nose masks of Unique are relatively straightforward representations of animal noses" (912 F.2d at 671) and referred to *Mazer* and *Herbert Rosenthal Jewelry Corp. v. Honora J. Co.*, 509 F.2d 64 (2nd Cir. 1974). In the latter case, no infringement was found because the similarities between the plaintiff's and defendant's pins came primarily from the general shape of turtles, referring to *Herbert Rosenthal* (1971). Accordingly, with respect to "art" objects, the First, Second, Third and Ninth Circuit Courts have all "narrowed" copyright protection to original contributions of the copyright owner.

The Ninth Circuit Decision Did Not Overlook Other Precedent

In *Metcalf v. Bochco*, 294 F.3d 1069 (9th Cir. 2002), the Ninth Circuit stated that

> **[P]rotectable expression includes the specific details of an author's rendering of ideas, or the 'actual concrete elements that make up the total sequence of events and the relationships between the major characters' ... Here, the similarities proffered**

> **by the Metcalfs are not protectable when considered individually; they are either too generic or constitute 'scenes a faire' . . . one cannot copyright the idea of an idealistic young professional choosing between financial and emotional reward, or of love triangles among young professionals that eventually become strained, or of political forces interfering with private action.**

Id., 294 F.3d at 1074. This holding by the *Metcalf* court is consistent with the Ninth Circuit's holding in this case that the selection of the clear glass and oblong shroud, bright colors, proportion, vertical orientation and a stereotype jellyfish form, considered together, lacks the quantum of originality needed to merit copyright protection.

In *Cavalier v. Random House*, 297 F.3d 815 (9th Cir. 2002), the Ninth Circuit warned that a court must take care to inquire only whether "the protectable elements, standing alone, are substantially similar". It stated that "a court must filter out and disregard the non-protectable elements in making its substantial similarity determination." Here, in its decision, the Ninth Circuit has in effect provided instructions to the district court to, on remand, "filter out and disregard the non-protectable elements in making its substantial similarity determination". The Ninth Circuit's decision is in complete harmony with *Cavalier*.

Petitioner misstates the holdings in *Kamar*, *Cavalier*, *Knitwaves* and *Metcalf*. The *Kamar* court held that infringement must be based on "substantial similarity in the expression of the ideas". It remanded the case to the trial court for a specific decision upon the validity of the copyright and a reexamination of the question of infringement.

Cavalier and *Metcalf* both held that "a court must filter out and disregard the non-protectable elements in making its substantial similarity determination". Here, that is what the Ninth Circuit did in its decision.

Feist Has Application To All Works

The *Feist* court stated that the essential ingredient present in creations, but absent in facts, is originality, "the *sine qua non* of copyright". *Feist*, 499 U.S. at 345. Here, the Ninth Circuit correctly treated the standard jellyfish features of a bell at the top and tentacles depending from the bell and the standard shroud shape of bulbous at the top and tapering toward the bottom as being "discoverable facts". These features were not the product of Petitioner's creativity. They are non-protectable elements that a court must filter out and disregard in making its substantial similarity determination.

The Ninth Circuit Did Not Overlook And/Or Distort Facts In The Record

It is undisputable, clear glass and oblong shrouds are commonplace aspects of the glass-in-glass medium. Clear glass sculptures are presented throughout ER 83-ER 143. For example, Item 752 on ER 89 is described on ER 88: "colorless glass encloses red lily flower". Several bright colored objects in clear glass are displayed on ER 103. Clear crystal is shown on ER 109 to enclose brightly colored objects. Clear glass shrouds surrounding colorful objects are shown on ER 115-ER 118. ER 127 defines "crystal" as being "a high-quality clear, colorless glass". It is undisputable, the "gather" shaped shroud is a common shroud shape in the "public domain". This is unprotectable

"discoverable fact", not "protectable expression". See, for example, Item 46 on ER 87, Item 83 on ER 91, Item 709 on ER 93 and Item 254 on ER 97. See also the items shown at the lower right corner on ER 117.

Nature provides a jellyfish with bright colors, with a bell at its top and tentacles depending from the bell, which are typical elements of jellyfish physiology. These facts are established by "A Guide to the World of Jellyfish". See ER 144-ER 163, and in particular ER 150. That guide states that jellyfish swim upwardly in the water. See page 11 of ER 156. It is not even original in the glass art to depict a jellyfish in an upright or vertical position. See ER 244-ER 250.

Recognizing the physiognomy of jellyfish and the nature of the glass-in-glass art medium, both of which are clearly set forth in easy to read publications, does not constitute overlooking and/or distorting facts in the record. Very clearly, these "facts" are in the record and they provide a firm basis for this Court's application of the controlling law to the "facts".

Aliotti Is Of Primary Importance

The *Aliotti* court stated that "[a]ppellants therefore may place no reliance upon any similarity in expression resulting from either the physiognomy of dinosaurs or from the nature of stuffed animals". *Id.*, 831 F.2d at 901. Here, the Ninth Circuit states that Petitioner could place no reliance upon any similarity in expression resulting from either the physiognomy of jellyfish or from the nature of glass-in-glass art objects. The *Aliotti* court instructed that "a court must filter out and disregard the non-protectable elements in making its substantial similarity

determination". The record clearly establishes that many jellyfish have bells at their tops and tentacles depending from their bells and jellyfish swim vertically upwardly at times. The record also clearly shows that it is very commonplace to make a shroud from clear glass. The basic object of glass-in-glass art is to provide a sculpture inside of a shroud that can be easily seen and appreciated by persons looking through the shroud. The Ninth Circuit recognized that Petitioner's jellyfish included protectable features, such as the specific bell and tentacle shapes and color hues.

In its decision, the Ninth Circuit reviewed the underlying issue of law and then considered the record facts with respect to that law. As pointed out above, it followed the law of the Ninth Circuit when it held that Petitioner may not place any reliance upon any similarity in expression resulting from either the physiognomy of jellyfish or from the nature of the glass-in-glass art medium. The record facts clearly establish that a common form of jellyfish has a bell at its top and tentacles depending from the bell and jellyfish swim vertically upwardly as well as in other directions. The Ninth Circuit referred to the record when it stated that the use of clear glass and the use of a shroud that is rounded at its top and tapers towards its bottom are not creations of Satava, but rather are common features in the glass-in-glass art medium free for all to use. The record facts include publications showing the physiognomy of jellyfish and the common shroud shapes and materials used in the glass-in-glass art medium. It is clear, that the district court's look at the record facts had been done in light of an erroneous view of the applicable law.

The Line Between Protectable And Unprotectable Features Has Been Established By The Ninth Circuit's Precedent

The line drawn between protectable and unprotectable features has been established by the precedent of the Ninth Circuit (e.g. *Aliotti*) and by this Court in *Feist*. Quite clearly, the Ninth Circuit did not create a new legal standard, but rather followed the existing legal standard with respect to the copyright protection afforded subject matter composed of a combination of protectable and unprotectable elements. After stating the proper legal standard, it was proper for the Ninth Circuit to look at the record and identity the unprotectable elements. In this case, they consisted of expression resulting from the physiognomy of jellyfish and common elements of glass-in-glass art objects, including the use of clear glass and a common shroud shape, both of which are in the public domain available for all to use.

CONCLUSION

For the reasons set forth above, this Court is asked to deny Petitioner's petition.

Respectfully submitted,

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Dated:
September 29, 2003

(4)

Supreme Court, U.S.
FILED
OCT 20 2003
OFFICE OF THE CLERK

No. 03-314

IN THE

Supreme Court of the United States

RICHARD SATAVA, an individual; SATAVA ART GLASS, a sole proprietorship,

Petitioners,

v.

CHRISTOPHER LOWRY, an individual; CHRISTOPHER RICHARDS, an individual; MAKAWAO GLASSWORKS, LLC, dba HOT ISLAND GLASS,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

REPLY BRIEF

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STATEMENT PURSUANT TO RULE 29.6

Petitioner, Satava Art Glass's corporate disclosure statement was set forth at page *ii* of its Petition for a Writ of Certiorari, and there are no amendments to that statement.

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INTRODUCTION

Respondents contend the Ninth Circuit's Opinion does not conflict with precedent because, they say, it does not establish a new threshold test for protectability to deprive art of copyright protection previously available under *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903) and its progeny. But Respondents ignore the first 11 pages of the 13-page Opinion, and the core holdings asserted therein, which the Ninth Circuit itself just read to require that it invalidate a copyright in a sculptural work on the ground the work was not sufficiently original to merit protection. *Lamps Plus, Inc. v. Seattle Lighting Fixture Co.*, __ F.3d __, 2003 WL 22285309 (CA9 Oct. 6, 2003). As the Ninth Circuit's own reading of its Opinion illustrates, and as the amici curiae brief filed in support of Petitioner Satava confirms, certiorari should be granted because the Opinion alters copyright law and narrows copyright protection for all art – not just depictions of animals – in a manner that conflicts with *Bleistein* and several circuits.

I. Certiorari Should Be Granted Because New Authority In The Ninth Circuit Confirms The Opinion In This Case Imposes A New Threshold Test That Deprives Artists Of Copyright Protection And Conflicts With Precedent

In his petition, Satava presented the questions of whether elements in a work of art said to be a "realistic" depiction of an animal or other subject matter in the public domain, or the combination of elements in such a work, were unprotectable under copyright law. Pet. *i* (Questions Presented 1 and 2). Respondents do not deny that such holdings would conflict with the precedent of this Court and other circuits, but rather attempt to portray the Opinion as not so holding by ignoring the first 11 pages of the Opinion.

Respondents' inability to reconcile the first 11 pages with precedent underscores the need for certiorari because those pages: (1) pose a threshold question "whether an artist's lifelike glass-in-glass sculptures of jellyfish *are protectable* by copyright," Pet. App. 2a; (2) hold those elements are

"*unprotectable*" because animals are in the public domain, *id.* at 9a; and (3) hold Satava's combination of elements, "lacks the quantum of originality needed to merit copyright protection." *Id.* at 10a. Indeed, that is exactly how the Ninth Circuit itself read the Opinion earlier this month:

> We have recently considered *the question whether a work* assembled from relatively few unprotectable elements *can be copyrighted as a sculptural work*, in *Satava v. Lowry*, 323 F.3d 805 (9th Cir. 2003). *Satava* concerned the *validity of a copyright* protecting the designer's glass-in-glass jellyfish sculptures. *Id.* at 808-10. In *Satava*, we ruled as follows:
>
> > Our case law suggests, and we hold today, that a combination of unprotectable elements is eligible for copyright protection only if those elements are numerous enough and their selection and arrangement original enough that their combination constitutes an original work of authorship.
> >
> > The combination of unprotectable elements in Satava's sculpture falls short of this standard. The selection of the clear galls, oblong shroud, bright colors, proportion, vertical orientation, and stereotyped jellyfish form, considered together, lacks the quantum of originality needed to merit copyright protection.
>
> *Id.* at 811 (internal citations omitted). Thus, we concluded in *Satava* that the combination of six *unprotectable* elements did not rise to the level of originality sufficient to merit copyright protection.
>
> . . . The Victorian Tiffany table lamp "lacks the quantum of originality needed to merit copyright protection." *Satava*, 323 F.3d at 811. [Plaintiff] Lamps Plus is *unable to survive the necessary first step*

> *of an infringement action because the copyright is invalid.* Consequently, we do not reach the question of whether the two lamps are substantially similar.

Lamps Plus, __ F.3d __, 2003 WL 22285309, at *6 (emphasis added). The Ninth Circuit is the fourth court in the past few months to apply its Opinion to deny or greatly restrict copyright protection for sculptural and or other works.[1]

The Ninth Circuit thus reads its Opinion in this case as (1) imposing a threshold test for determining whether works are protectable, (2) holding *all* six elements in Satava's art – including, necessarily, his depiction of a jellyfish – individually unprotectable, and (2) holding his combination of elements not sufficiently original to merit copyright protection. The Ninth Circuit then takes the Opinion to its logical conclusion, using it to invalidate the copyright for a sculptural work, *id.* at *3, on the ground the plaintiff could not survive the threshold test for originality established by the Opinion in this case. *Id.* at *6-7.

In this way, the Ninth Circuit not only confirms the overriding problem with the Opinion, it also reveals that the problem is greater than might appear on first blush. In *Lamps Plus*, the Ninth Circuit demonstrates that the Opinion's consequences extend far beyond works of art that depict animals and instead will be used to import from the law governing factual compilations a new threshold test for copyright protection of any sculptural or other work of art, regardless of whether it is based on scenes drawn from nature

---

1. *See also Inkadinkado, Inc. v. Meyer*, 2003 WL 22282177, at *3 (D. Mass. Sept. 16, 2003) (denying preliminary injunction to artist on the ground that any protection in her compilation (a collage) was as "thin" as the protection, if any, given to factual compilations such as directories) (quoting Pet. App. 12a); *Cottrill v. Spears*, 2003 WL 21223846, at *9 (E.D. Pa. May 22, 2003) (quoting Opinion to find plaintiff's combination of elements insufficiently original to merit protection); *Osvaldo Garcia-Coyco v. Puerto Rico Highway Authority*, 275 F. Supp. 2d 142, 150 (D.P.R. 2003) (citing and quoting Opinion to justify invalidating copyright).

or other subject matter in the public domain. The Ninth Circuit's application of the Opinion in *Lamps Plus* thus emphasizes the need for certiorari in this case.

II. Certiorari Should Be Granted Because Respondents Do Not Even Attempt To Reconcile The Opinion With The Relevant Holdings Of *Bleistein* And Must Treat Art As "Facts" In A Vain Attempt To Reconcile It With *Feist*

In his petition, Satava explained why the Opinion could not be reconciled with *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903), and posed the questions of whether the Ninth Circuit's holdings also misapplied to *art* the rule regarding *factual* compilations set by *Feist Pubs., Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991). *See* Pet. *i* (Questions 2 and 3).

Just as Respondents can only deny the need for certiorari by ignoring the pertinent passages in the Opinion, they can only deny the conflict with *Bleistein* by ignoring its relevant holdings. *Bleistein* not only addressed the issue cited by the opposition (whether art used in advertisement is protectable), but also addressed whether plaintiff's lithographs were not sufficiently original to merit protection because they depicted actual scenes from a circus. 188 U.S. at 249. In rejecting this argument, Justice Holmes rejected *all* the foundational underpinnings of the Opinion.

First, Justice Holmes held copyright protection "is *not affected* by the fact, if it be one, that the pictures represent actual groups – visible things. . . . [E]ven if they had been drawn from the life, that fact would not deprive them of protection." *Id.* (emphasis added). Not only is this holding violated by the part of the Opinion Respondents ignore, it is also violated by that part Respondents quote, which holds a defendant *may* copy with impunity an artist's "'expression'" of what "'nature displays for all observers,'" and artists may only protect that part of their art, if any, that *varies* the depiction from the lifelike. Opp. 5 (quoting Pet. App. 12a). *Bleistein* holds the opposite. *Compare id.* and Pet. App. 7a-8a (Satava's sculptures unprotectable because, *inter alia*, jellyfish are "part of the public

domain" and thus "the common property of all") *with Bleistein*, 188 U.S. at 249 (such propositions "would mean that a portrait by Velasquez or Whistler was common property because others might try their hand on the same face. Others are free to copy the original. They are not free to copy the copy.").

Second, Justice Holmes explained that the combination of elements in even the simplest work of art was sufficiently original to merit copyright protection:

> There is no reason to doubt that these prints in their *ensemble* and in all their details, in their design and particular combinations of figures, lines, and colors, are the original work of the plaintiffs' designer. . . . It would be pressing the defendant's right to the verge, if not beyond, to leave the question of originality to the jury upon the evidence in this case. . . .

Id. at 250 (emphasis in original). It is apparent that this part of *Bleistein* cannot be squared with the Opinion's determination, ignored by Respondents, that an artist's combination of elements – which in this case was not only original but novel in that neither the Opinion nor Respondents deny that no artist had combined these elements in this fashion before Satava – lack sufficient originality to be protectable. Pet. App. 10a.

Finally, Justice Holmes rejected the theory that copyright protection for a work of art can be denied or limited based on comparison to factual compilations like a directory. *Id.* ("The least pretentious picture has more originality in it than directories and the like, which may be copyrighted."). In this way, *Bleistein* reveals the Opinion erred by extending the rule in *Feist*, which denies or limits copyright protection to directories and other factual compilations, to deny or limit copyright protection for art.

Respondents prove the point by conceding "[t]he *Feist* Court stated that the essential ingredient present in *creations*, but absent in *facts*, is originality. . . ." Opp. 12 (quoting *Feist*, 499 U.S. at 345) (emphasis added). To fit the Opinion's broad holding into the narrow rule of *Feist*, Respondents are

compelled to treat jellyfish sculptures as "facts," not as "creations," *id.*, but cannot cite even one other case using *Feist* to limit protection for artistic "creations." As confirmed by the amici curiae brief filed in support of Satava's petition, certiorari is necessary to prevent this erroneous extension of *Feist* to deny copyright protection to works of art.

III. Certiorari Should Be Granted To Address Conflicts Between The Opinion And Other Circuits That Respondents Do Not Attempt To Reconcile As To Four Circuits And Highlight As To Three Others

In his petition, Satava noted that the Opinion conflicts with decisions in at least seven other circuits. Amici curiae also observed that certiorari is required to resolve a conflict between the circuits as to when art, and the combination of elements that constitute a work of art, exhibits sufficient "creativity" to be protectable after *Feist*. *See* Amici Brief 4 (citing conflict between the Opinion and *Boisson v. Banian, Ltd.*, 273 F.3d 262 (CA2 2001)).

In opposition, Respondents can only argue that no conflict exists in the lower courts by ignoring several cases that conflict with the Opinion. Among others, Respondents never cite nor discuss the conflict between the Opinion and *Boisson*, *Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127 (CA2 2003); *Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488 (CA4 1996); *Cannon Group, Inc. v. Better Bags, Inc.*, 250 F. Supp. 2d 893 (S.D. Ohio 2003) or any case outside the Ninth Circuit discussed in Pet. 18 n.15. These omissions are telling, for the cases Respondents fail to address highlight the conflict between the way these courts read *Bleistein* and/or *Feist* – and the greater copyright protection they accordingly give to artists and their creations than the Ninth Circuit – and the effect of the Ninth Circuit's failure to cite or follow *Bleistein* and its misapplication of *Feist*, which led it to significantly narrow copyright protection for artists and their creations. As a result, there are now two different

standards in the circuits for determining when and to what extent art will receive copyright protection.

Even the few decisions Respondents do address do not support their argument that no conflict exists between the Opinion and the other circuits. In each case, both the reasoning and result conflicts with the Ninth Circuit.

As even Respondents acknowledge, the First Circuit grants copyright protection to an artist's entire "'realistic-looking'" animal sculpture - not just to any variations added by the artist that alter his or her rendition from how the animal looks in nature. Opp. 8-9 (quoting *Concrete Machinery Co. v. Classic Lawn Ornaments*, 843 F.2d 600, 607-08 (CA1 1988). Contrary to the Ninth Circuit's approach, in the First Circuit the amount and nature of the artist's variations have nothing to do with plaintiff's entitlement to copyright protection, but are used during comparison of the parties' works to determine whether defendant's depiction of the animal copied plaintiff's rendition. 843 F.2d at 607-09. The Ninth Circuit never conducts this analysis; having erroneously concluded that Satava had no meaningful protection, the Opinion does not undertake an infringement analysis and never compares Satava's work with Respondents' to determine if they replicated his art (which, as the district court found, they had).

Respondents also concede that, in the Second Circuit, Satava's art would merit the very protection the Ninth Circuit denied. Opp. 9-10 ("'[o]riginality in this context means little more than a prohibition of actual copying'") (quoting *Rushton v. Vitale*, 218 F.2d 434, 435 (CA2 1955) (upholding copyright protection in chimpanzee soft sculptures based on live models because). Neither the Opinion nor Respondents claim that Satava copied any prior work, yet the Opinion denies copyright protection to Satava's sculptures because they supposedly depict actual jellyfish and "lack[] . . . originality. . . ." Pet. 10a.

As Respondents also concede, the Third Circuit accords copyright protection to "'relatively straightforward

representations of animal[s].'" Opp. 10 (quoting *Masquerade Novelty, Inc. v. Unique Industries, Inc.*, 912 F.2d 663, 671 (CA3 1990). Unlike the Ninth Circuit, the Third Circuit recognized that, under *Bleistein*, resolution of this type of case turns not on the protectability *vel non* of the art - since art is sufficiently original to merit protection - but on whether defendant copied plaintiff's realistic depiction of the animal. 912 F.2d at 671 (citing *Bleistein*).[2]

At the end of the day, Respondents' contention that the Opinion does not conflict with precedent turns on their untenable assertion that the Opinion does not hold Satava's sculptures to be unprotectable. Since the Ninth Circuit in *Lamps Plus* reads the Opinion to so hold, the conflict between the Opinion and the precedent cited by Respondents cannot be brushed aside on that basis.

That conflict is well-illustrated by the final case Respondents address, *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996 (CA2 1995). Contrary to Respondents' reading, *Knitwaves* did not adopt or follow what they contend is the holding of *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759 (CA2 1991). Rather, the Second Circuit explicitly said that the appellant in that case - like Respondents here - accorded *Folio Impressions* "too broad a reading." *Knitwaves*, 71 F.3d at 1003. As the Second Circuit explained, the plaintiff in *Folio Impressions* "photocopied the background from a document . . . which was admitted to be in the public domain." *Id.* Because it was a direct *photocopy* - not an artist's rendition - "[t]he studio had 'contributed nothing, not even a trivial variation,'" the "background design was entirely devoid of originality" and "was not copyrightable." *Id.* (quoting *Folio Impressions*, 937 F.2d at 764). *Knitwaves*

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2. On remand, the district court in *Masquerade Novelty* found the similarities between the parties' renditions outweighed differences in the variations each had added, and thus found defendants' animal sculptures (in the form of masks) infringed plaintiff's work. 1990 U.S. Dist. LEXIS 16980 (E.D. Pa. 1990).

distinguished *Folio Impressions* from its facts – and from other cases involving art that was not photocopied from a document in the public domain – by noting that, under *Feist*, any work that "'was independently created by the author (as opposed to copied from other works), and that . . . possesses at least some minimal degree of creativity,'" is sufficiently original to merit copyright protection. *Id.* at 1004 n.3 (quoting *Feist*, 499 U.S. at 345).

Knitwaves also reveals the fundamental analytical flaw in the Ninth Circuit's Opinion. In *Knitwaves*, the Second Circuit never asks the threshold question posed by the Ninth Circuit because it was clear plaintiff's Squirrel and Leaf sweater design was not directly copied from another work and therefore was original and protectable. 71 F.3d at 1002; *see id.* at 1003-04 & nn.1 & 3. The question of originality and the scope of protection arose in the substantial similarity analysis, in which defendant argued that the Second Circuit should dissect out any unprotectable elements in plaintiff's design and not include those in its comparison with defendant's design. *Id.* at 1003. The Second Circuit *refused* to do so, explaining that "if we took this argument to its logical conclusion, we might have to decide that there can be no originality in a painting because all colors of paint have been used somewhere in the past." *Id.* (quotation omitted). In comparing "the works' 'total concept and feel,'" the Second Circuit compared plaintiff's combination of elements – the overall work, which the Ninth Circuit here found unprotectable – to defendant's and found the latter substantially similar and thus infringing. *Id.* at 1003-04.

As *Knitwaves* illustrates, the question of which elements in a plaintiff's art may be unprotectable leads to a much different answer and result when correctly considered as part of the substantial similarity analysis than if that question is converted into a stand-alone threshold test. Among other reasons, that is because any analytic dissection of unprotectable elements in the extrinsic prong of the substantial similarity analysis is balanced by comparing the "total concept and feel" of the parties' works in the intrinsic part of the test. *Id.* Taken out of that balanced context, the

analysis becomes one-sided and distorted, leading to a narrow view of what art is protectable that cannot be squared with a century of precedent finding virtually all art to be sufficiently original to be protectable, even if, in a given work, each element might independently be unprotectable. *Id.*; Pet. 18 n.15 (citing five cases so holding).[3]

CONCLUSION

As the concerns of amici curiae and the new authority from the Ninth Circuit illustrate, certiorari should be granted and the Opinion below reversed to protect both the uniform development and application of the Copyright Act and the ability of artists to obtain and enforce copyright registrations for their art. As shown by the Ninth Circuit's recent decision in *Lamps Plus*, unless certiorari is granted future courts will read and apply the Opinion to invalidate copyright registrations and eviscerate copyright protection for sculptural and other works of art. As shown by Respondents' own opposition, this reasoning and result does and will conflict with the precedent of this Court and decisions in at least seven other circuits. For all these reasons, the petition for certiorari should be granted and the Opinion below reversed.

---

3. As explained in the Petition, the Ninth Circuit was only able to hold that Satava's constituent elements were unprotectable by ignoring the factual findings of the district court, which the Ninth Circuit never addressed nor found to be clearly erroneous. Instead, the Ninth Circuit relied on a number of its own personal misconceptions, which were at odds either with the factual record, *see, e.g.*, Pet. 9 n.2, or with the district court's factual findings, *see, e.g.*, Pet. 5 & n.1 and 23 & n.20. As part of their attempt to defend the indefensible, Respondents repeatedly make the same mistake; both their "Factual Background" and argument sections rely on factual assertions the district court *rejected* in its factual findings. *Compare, e.g.*, Opp. 2 (asserting "shroud" of outer glass was "a common shape that results from [the shape of the] object inside" and was thus easier and more economical to make) *with* Pet. App. 23a (rejecting this assertion based on evidence presented by Respondents as well as Satava); *and* Opp. 12-13 (asserting shape of Satava's shroud was "common" and thus in the "'public domain'") *with* Pet. App. 23a (finding shape of Satava's shroud was a "unique feature" of his art not in the public domain).

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Supreme Court, U.S.
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No. 03-314

In the Supreme Court of the United States

Richard Satava, et al.

Petitioners

v.

Christopher Lowry, et al.

Respondents

On Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

Brief of *Amici* Ralph D. Clifford *et al.* Supporting Richard Satava's Petition for Writ of Certiorari

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Interest of the *Amici Curiae*[1]

Amicus Ralph D. Clifford is a law professor at Southern New England School of Law who specializes in intellectual property issues, specifically including the requisite creativity needed for copyright. *See, e.g.*, Ralph D. Clifford, *Intellectual Property in the Era of the Creative Computer Program: Will the True Creator Please Stand Up?*, 71 Tul. L. Rev. 1675 (1997). His only interest in the case is to assist in the interpretation of the Copyright Act, Title 17 of the United States Code as amended.

Amicus Bay Area Studio Art Glass [BASAG] is a non-profit association founded in 1975. It is comprised of professional glass artists and studios in the San Francisco, California area. Its members include a diverse group of artists who are recognized in both the national and international studio glass movement. BASAG provides its members with a variety of services including a forum to exchange information, experiences, techniques and ideas; referrals; networking; and opportunities for collaboration or participation in shows, festivals and galleries. BASAG's interest in the case is to restore copyright protection to the works of art produced by its members.

Amicus Robert Quade is a sculptor with a studio in Indiana. His statues vary from realistic portrayals of humans, particularly dancers, to abstracts. He distributes his work

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1. This brief was written exclusively by the *amici's* counsel with the generous financial support of the Southern New England School of Law. No counsel for a party authored any portion of this brief. The institutional affiliation of *Amicus* Ralph D. Clifford is for identification only as he does not purport to represent the position of his institution.

This brief is submitted with the written consent of the parties.

throughout the nation, including within the Ninth Circuit. His interest in the case is to seek a nationwide standard of copyright creativity to be able to protect his works, wherever they are.

Summary of Argument

Although a modicum of creativity is needed in order for a copyright to subsist in an expressive work, this Court has only addressed the evaluation of the quantity of creativity present in the context of a factual compilation. *See Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991). Because there are major differences between factual compilations and more fanciful works such as sculptures, the lower courts have no clear guidance regarding the requisite and some of their decisions have dissolved into what can only be described as exercises in judicial censorship, allowing copyright only if the judges subjectively appreciate the creativity of the work. Further, the imprecise standard of creativity for fanciful works has resulted in courts demanding novelty in expression before a copyright will be recognized. Consequently, adequately creative works are being denied copyright protection in some circuits. The case at bar is an excellent opportunity to clarify this area of copyright law and to resolve the inter-circuit disagreements.

Language in *Feist* instructs that copyrighted works should be based on a "creative spark." *Id.* at 345. This expectation of a conscious moment of inspiration in the creation of the work is not a realistic one given the manner in which the human brain works. The case at bar would allow refocusing of the creativity test, from expecting a "spark" to finding selection among expressive choices.

Argument

There are two reasons why this Court should grant the writ of certiorari. First, elaboration of the standard of creativity for fanciful rather than non-fiction compilations is needed. Second, clarification is needed to insure that the creativity required by the copyright law is of a character that is in keeping with the scientific understanding of how a human brain works.

I. A Writ of Certiorari Should Be Granted to Define the Minimal Creativity Requirements for Fanciful Works

In *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), this Court established that there is a threshold of creativity that must be contained within a compilation of facts in order for a copyright to subsist. *See id.* at 348. The Court stated:

> [T]he work [must be] independently created by the author (as opposed to copied from other works), and [must] possess[] at least some minimal degree of creativity. To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, no matter how crude, humble or obvious it might be. Originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying.

Id. at 345 (citations and quotation marks omitted).

While the Court's opinion suggests that this creativity requirement is a requisite of all copyrighted works, not just compilations, *see id.*, the Court's discussion of creativity in the context of a factual compilation provides clouded guidance as to the nature of the requirement for more fanciful works such as the one in the case at bar. The resulting contradictory holdings of the circuit courts bear witness to the need for a clarifying ruling. *Compare, e.g., Satava v. Lowry*, 323 F.3d 805 (9th Cir. 2003) (disallowing copyright in an artistic glass jellyfish sculpture) *with Boisson v. Banian, Ltd.*, 273 F.3d 262 (2d Cir. 2001) (allowing copyright in much simpler quilt design).

For a compilation of facts such as that addressed in *Feist*, the analysis of creativity correctly scrutinizes the work to insure that it is comprised of something in addition to a simple list of facts. Consequently, some "selection and arrangement" of these facts must be found for a copyright to subsist. *Feist*, 499 U.S. at 348. The work before the Ninth Circuit in the case at bar, however, was not a compilation of facts; instead, it was a sculpture created to reflect the artist's impression of a jellyfish. *See Satava*, 323 F.3d at 807. As such, the type of extra scrutiny afforded by the Ninth Circuit when it examined what it identified as the component parts of Satava's statue followed by a determination that they had not been selected or arranged in a creative way, *see id.* at 810-11, was improper.

The Circuit's apparent insistence that Satava's work be novel, *cf. id.* at 812,[2] further demonstrates the lower court's

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2. "These elements are so commonplace in glass-in-glass sculpture and so typical of jellyfish physiology that to recognize copyright protection in their combination effectively would give Satava a monopoly on lifelike glass-in-glass sculptures of single jellyfish with vertical tentacles."

misunderstanding of *Feist* as the warning that copyright creativity does not require "novelty," *Feist*, 499 U.S. at 345,[3] was not effectuated. Many of elements that comprise Satava's statue were rejected by the Ninth Circuit because they were "standard, stock, or common." *Satava*, 323 F.3d at 810. Effectively, the Ninth Circuit's standard in dealing with realistic art discounts entirely the amount of intellectual labor needed to render a natural scene in an expression. *Cf. id.* at 813. After all, the creation of a life-like sculpture by one artist prevents no other artist from creating a similar sculpture as independent creation overcomes the presumption of copying. *See, e.g., Arnstein v. Edward B. Marks Music* Corp., 82 F.2d 275, 275 (2d Cir. 1936) (L. Hand); *Moore v. Kulicke & Soffa Ind., Inc.*, 318 F.3d 561, 573-74 (3d Cir. 2003); *Calhoun v. Lillenas Pub.*, 298 F.3d 1228, 1233-34 (11th Cir. 2002), *cert. denied*, 123 S. Ct. 2251 (2003). If the Ninth Circuit's test is accurate, then works such as the petitioner's – or even works so clearly creative as John Audubon's *Birds of America* – would no longer be copyrightable.

At the same time, it would be inappropriate to suggest that no scrutiny is needed for fanciful works, particularly where the work is based on a realistic representation of something that actual exists. Indeed, it is exactly this point where copyright law has been incomplete articulated. The statement in *Feist* that a "creative spark" is needed, *Feist*, 499 U.S. at 345, does nothing to explain what is required; instead, the language is an invitation for the lower courts to find creative that which they appreciate while denying copyright to works which fail to satisfy the lower courts' subjective estimation of creative

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3. "Originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying."

works. Consequently, judicial censorship, much feared by this Court a hundred years ago in *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251-52 (1903),[4] is the probable result of the current state of the copyright law.

This court should clarify the standard of creativity for fanciful works. At its core, *Feist* seemed most concerned with the choices that were available to and made by the author. *See Feist*, 499 U.S. at 348.[5] To expand the *Feist* holding to fanciful works, two prerequisites should be expected of an author. First, multiple ways should exist for an expression to be made and, second, the author should have made selections from these choices. *See id.* In other words, did the author, having a choice, *decide* to express the work in the way it was done; did the author "make a judgment, ... determine a preference; [or] come to a conclusion," *Random House Unabridged Dictionary* 517 (2d Ed. 1993), about the expression used? Without the guidance of this Court, however, the lower courts will continue to misconstrue the quantum of creativity required in fanciful works. This court should rectify the problem by granting certiorari in this case.

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4. "It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. ... At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge."

5. "The compilation author typically chooses which facts to include, in what order to place them, and how to arrange the collected data so that they may be used effectively by readers. These choices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original that Congress may protect such compilations through the copyright laws."

II. A Writ of Certiorari Should Be Granted to Make the Copyright Creativity Requirement Consistent with Neuroscience

The *Feist* case describes the creativity requisite as requiring the author to create the work based on a "creative spark." *Feist*, 499 U.S. at 345. These two words appear to have caused many courts to expect a much higher level of creativity than the"crude, humble or obvious," *id.*, level *Feist* required. *See, e.g., J. Thomas Distrib., Inc., v. Greenline Distrib., Inc.*, 100 F.3d 956 at *2 (6th Cir. 1996) (table, opinion at 1996 WL 636138) (drawing of part lacks creative spark); *Southco, Inc. v. Kanebridge Corp.*, 258 F.3d 148, 152 (3d Cir. 2001) (part numbers lack creative spark); *Mid Am. Title Co. v. Kirk*, 59 F.3d 719 (7th Cir.) (title commitment lacks creative spark), *cert. denied*, 516 U.S. 990 (1995); *Mitel, Inc. v. Iqtel, Inc.*, 124 F.3d 1366 (10th Cir. 1997) (command codes lack creative spark),

Describing creativity as was done in *Feist* leads to a judicial expectation that cannot be satisfied for more fanciful works than that involved in *Feist*. *See* Martha Woodmansee, *Response to David Nimmer*, 38 Hous. L. Rev. 231, 231 (2001).[6] In the case at bar, for example, the Ninth Circuit was expecting to find a moment of conscious inspiration which it could not find. *Cf. Satava v. Lowry*, 323 F.3d 805, 812 (9th Cir. 2003).[7] In this expectation, the Ninth Circuit misapplied the intent

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6. Professor Woodmansee discounts a creative spark as a "Romantic (mis)representation of creative activity."

7. "Because the quantum of originality Satava added in combining these standard and stereotyped elements must be considered "trivial" under our case law, Satava cannot prevent other artists from combining them."

behind the constitutionally required creativity requirement of rewarding authors for expressing their ideas. *See Feist*, 499 U.S. at 349.

Further, describing creativity as a "spark" and expecting a conscious moment of inspiration is an inaccurate description of how the human brain works. *See* William H. Calvin, *The Cerebral Code* 21 (1996).[8] There is increasing scientific evidence that the primary source for novel thoughts is chance rather than conscious thought. *See id.*;[9] Henry Krystal & Andrew D. Krystal, *Psychoanalysis and Neuroscience in Relationship to Dreams and Creative* in Creativity and Affect 185, 196 (Melvin P. Shaw & Mark A. Runco, eds. 1994).[10] As Professor Calvin describes it, creative thoughts can be generated in a process that starts with chance, William H.

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8. Professor Calvin, a leading neuroscientist based at the University of Washington, explains that the scientific evidence regarding creativity supports the hypothesis that chance – rather than conscious thought – is the origin of creativity.

9. Among the six "essential aspects" of creativity are that "[v]ariant patterns ... be produced by chance.".

10. "One critical feature of any model of creativity is the ability to generate novel behavior. As we shall see below, 'chaotic,' nonlinear systems are capable of generating novel, unpredictable behavior and are, therefore, useful models of creativity."

Calvin, *The Cerebral Code* 21, noise, *cf. id.* at 66,[11] or an error, *cf. id.* at 100,[12] within the brain.

> Our more intelligent mental states are sometimes said to flirt around the "edge of chaos." This term is from complexity theory, which envisages an adaptive system that ranges between a rigid order and a more flexible disorder, controlling the degree of permitted disorder. We may range from satisfaction at getting something right (convergent thinking) to blue-sky divergent thinking; in those more creative moments, some of our cortical systems may be poised near the edge of chaos.

Id. at 67.

Consequently, the description of the constitutionally required creativity under the Intellectual Property Clause, U.S. Const. art. I, § 8, cl. 8,[13] should be reexamined to insure that the legal expectation of the needed creativity is realistic. While a

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11. The "pitter-patter of inputs" from outside of the brain can change the brain's response. Taking advantage of noise to generate creative ideas has been confirmed by artificial intelligence research. *See* Stephen Thaler, *Neural Nets that Create and Discover*, PC AI, May-June 1996, at 16, 16-18.

12. Professor Calvin notes that creative thoughts require "relaxing error correction" within the brain.

13. "The Congress shall have power ... to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive rights to their respective writings and discoveries."

conscious "creative spark" may be impossible to identify, a pattern of choices is not. By requiring the lower courts to focus on this actual evidence of creativity, the risks of judicial censorship, as found in the Ninth Circuit in the case at bar, can be eliminated.

Conclusion

For the reasons discussed above, the Court should grant the writ of certiorari and examine the decision of the Ninth Circuit Court of Appeals. Having done so, this Court should reverse the decision below.

Respectfully submitted: September 25, 2003,

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